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Supreme Court, U.S.
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NO. _____

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1991

BB ASSET MANAGEMENT, INC., TRANSFEREE
THROUGH BROWN BAG SOFTWARE, INC.

PETITIONER

VS.

SYMANTEC CORPORATION AND JOHN L. FRIEND, AN
INDIVIDUAL AND dba SOFTWORKS DEVELOPMENT

RESPONDENTS

PETITION FOR WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

I. IS A PARTY TO LITIGATION DEPRIVED OF ITS CONSTITUTIONAL RIGHT TO COUNSEL OF ITS CHOICE UNDER THE FIFTH AND SIXTH AMENDMENTS WHEN THE COURT DENIES THAT PARTY ACCESS TO THE CONFIDENTIAL DOCUMENTS UNDER A PROTECTIVE ORDER IN THE CASE SOLELY BECAUSE THAT PARTY'S TRIAL COUNSEL IS THAT PARTY'S IN-HOUSE GENERAL COUNSEL?

II. IN PERFORMING A COMPARISON OF TWO COMPUTER SOFTWARE PROGRAMS UNDER THE COPYRIGHT LAW TO DETERMINE IF THE TWO PROGRAMS ARE SUBSTANTIALLY SIMILAR:

A. SHOULD THE COURT COMPARE THE OVERALL "LOOK AND FEEL" OF THE TWO PROGRAMS OR MAY THE COURT MERELY COMPARE CERTAIN ELEMENTS OF THE TWO PROGRAMS?

B. SHOULD THE COURT RESOLVE THE IDEA/ EXPRESSION DICHOTOMY BY APPLYING THE ABSTRACTIONS SCALE OF JUDGE LEARNED HAND?

C. SHOULD THE USE OF LAY AND EXPERT OPINION BE ALLOWABLE IN A SINGLE SUBSTANTIAL SIMILARITY INQUIRY?

LIST OF ALL PARTIES

PETITIONERS

BB ASSET MANAGEMENT, INC., A NEVADA CORPORATION, TRANSFEREE OF CERTAIN ASSETS OF BROWN BAG SOFTWARE, INC., INCLUDING PC-OUTLINE, THE COMPUTER SOFTWARE PROGRAM WHICH IS THE SUBJECT OF THIS ACTION. (U.S. BANKRUPTCY COURT, NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE, CASE NUMBER: 59-05537MM.)

RESPONDENTS

SYMANTEC CORPORATION, A DELAWARE CORPORATION, AND JOHN L. FRIEND, AN INDIVIDUAL AND dba SOFTWORKS DEVELOPMENT

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IN THE SUPREME COURT OF THE

UNITED STATES OF AMERICA

OCTOBER TERM, 1991

BB ASSET MANAGEMENT, INC., TRANSFEREE THROUGH BROWN BAG SOFTWARE, INC.

PETITIONER

V.

SYMANTEC CORPORATION AND JOHN L. FRIEND, AN INDIVIDUAL AND dba SOFTWORKS DEVELOPMENT

RESPONDENTS

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Petitioner respectfully requests that a Writ of Certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Ninth Circuit entered in this proceeding on April 7, 1992.

CITATIONS TO OPINIONS BELOW

The opinion of the Court of Appeals, reported as Brown Bag Software, Inc., formerly Telemarketing Resources, Inc., v. Symantec Corp. and John L. Friend, an Individual and dba Softworks Development, 92 Daily Journal D.A.R. 4680 (9th Cir. 1992), appears as Appendix A to this Petition in the form printed by the court below. The page numbers of the appeals court's published opinion differ from those of the foregoing cite.

The final judgment of the District Court for the Northern District of California, reported as Telemarketing Resources, Inc. v. Symantec Corp. and John L. Friend, an Individual and dba Softworks Development (12 U.S.P.Q. 2d (BNA) 1991 (N.D. Cal. 1989), appears as Appendix B to this Petition.

The unpublished written order of the Magistrate "Order on Symantec's Motion for a Protective Order" appears as Appendix C to this Petition.

The unpublished written order of the Judge, "Order Denying Motion for Extension of Discovery Cut-off Date and Denying Motion for Reconsideration of Magistrate's Ruling," appears as Appendix D to this Petition.

JURISDICTION

The opinion of the Court of Appeals for the Ninth Circuit was entered April 7, 1992. This Petition for a Writ of Certiorari was filed within ninety days of that date. This Court's jurisdiction is invoked under 28 U.S.C. Section 1254 (1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article 1, Section 8, Clause 8 of the United States Constitution Appendix E

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STATEMENT OF THE CASE

I. NATURE OF THE CASE

Petitioner shall be referred to throughout this Petition as "Brown Bag" for continuity with the case below. The name "Brown Bag" shall include Brown Bag Software, Inc., BB Asset Management, Inc. and Telemarketing Resources, Inc.

Brown Bag is engaged in the marketing of computer software programs. One of the programs marketed by Brown Bag is PC-Outline, a personal information management system which, among other things, permits its user to organize, store and manipulate information in outline form. Much of PC-Outline's commercial success is attributable to the unique sequence, layout and organization of its features and audiovisual displays.

PC-Outline was created by Mr. John L. Friend ("Mr. Friend") and contains a substantial amount of material wholly original to Mr. Friend. PC-Outline constitutes copyrightable subject matter and is a protected work under the copyright laws of the United States (Certificate of Registration Number TX 1,953,313).

On April 17, 1987, Brown Bag and Mr. Friend entered into a written Purchase and Sale Agreement whereby Brown Bag acquired from Mr. Friend all right, title and interest in and to PC-Outline.

Mr. Friend developed another outlining program, an enhanced or updated version of PC-Outline, which Symantec Corporation ("Symantec") has been marketing under the name of GrandView since approximately April of 1988. (Mr. Friend stated in deposition that his new program initially had been titled PC-Outline 2.)

III. PROCEEDINGS BELOW

This is an action for copyright infringement arising under the Copyright Act of 1976, 17 U.S.C. Section 101 et seq.; the Trademark Law of the United States, 15 U.S.C. Section 1151 et seq.; and for related claims of breached contract, fraud and unfair competition. The district court had jurisdiction of the action under 28 U.S.C. Sections 1331, 1338(a) and the district court's pendant jurisdiction. Venue was proper in the district court under 28 U.S.C. Sections 1391 and 1400(a).

In February 1989, Brown Bag's retained counsel withdrew, and Brown Bag's new in-house general counsel was substituted in as counsel of record/trial counsel. (This substitution took place within 2 or 3 days of counsel's starting with the company.)

Symantec and Mr. Friend objected to providing Brown Bag's new trial counsel with confidential documents under the existing Protective Order which did not distinguish between outside and in-house counsel. On March 8, 1989, the Magistrate entered an Order (Appendix C) which denied Brown Bag's trial counsel access to the confidential material

designated "attorneys' eyes only" or "computer source code" under the Protective Order solely because he was in-house counsel. On April 24, 1989, the Judge entered an order which denied a motion for reconsideration (Appendix D).

Symantec and Mr. Friend moved for summary judgment, and Brown Bag's trial counsel opposed without having had access to the confidential information. On September 7, 1989, the district court entered judgment for Symantec and Mr. Friend on the copyright claim based on a "look and feel" analysis. In its confirming opinion, the appeals court below stated at P. 3729 that "...none of the trade secrets were themselves relevant to Brown Bag's "look and feel" infringement claim, a claim dependent on comparison of the two published programs." However, the first cause of action in Brown Bag's complaint was for copyright infringement which includes infringement by copying source code as well as by copying "look and feel." However, Brown Bag could not pursue the source code copying claim without a copy of GrandView's source code for comparison. Brown Bag was stopped from going forward with a source code copying claim since Brown Bag's counsel was denied access to Grandview's source code.

Brown Bag filed for bankruptcy protection on December 11, 1989. Subsequently, a secured creditor purchased certain assets of Brown Bag, including PC-Outline, at a foreclosure sale, and transferred these assets to the newly formed corporation, BB Asset Management, Inc.

Brown Bag also appealed the district court's decision to the United States Court of Appeals for the Ninth Circuit. On April 7, 1992, the appeals court below filed its opinion upholding:

1) The district court's denial of access to the confidential information under the protective order by Brown Bag's counsel, and

2) The district court's finding of no infringement on the computer software copyright claim.

3) The district court's refusal to admit the declaration of Brown Bag's expert.

The district court below did not evaluate the overall "look and feel" of the two programs. The appeals court below confirmed this approach at P. 3739 of its decision. The appeals court below stated at P. 3732 and P. 3733 of its decision:

> With regard to these five groups of features, the district court concluded that "many of the expressions which plaintiff argues are substantially similar are either not protected under the copyright or were licensed to Mr. Friend." Id. Thus, the court ruled, "[p]laintiff may not rely on these features in proving its case at trial." Id.

However, as is discussed later in this Petition, such features would be considered in an overall "look and feel" evaluation. While various elements may not be copyrightable, the unique combination of these elements may form copyrightable material.

Concerning the idea/expression dichotomy, the district court below stated at P. 1994:

> The idea of a computer run outlining program is undisputedly identical in both GrandView and PC-Outline.

Thus, Judge Learned Hand's "levels of abstraction" analysis was not employed by the district court or by the appeals court in Brown Bag.

The district court stated in Footnote 3 on P. 1994 that Mr. Ogg's declaration, which contained expert opinion as to the similarity of the two programs, would not be admitted. The appeals court stated on P. 3736 and P. 3737:

> To establish infringement of a copyright, the two works in question must also meet the second component of the test set forth in Krofft, the "intrinsic test." 562 F.2d at 1164. The intrinsic test, according to Krofft, should measure "substantial similarity in expressions...depending on the response of the ordinary reasonable person...[I]t does not depend on the type of external criteria and analysis which marks the extrinsic test." Id. (citations omitted). In applying the intrinsic test, therefore, "analytic dissection and expert testimony are not appropriate." Id.

REASONS FOR GRANTING THE WRIT

I. DENIAL OF ACCESS BY TRIAL COUNSEL TO THE CONFIDENTIAL DOCUMENTS UNDER A PROTECTIVE ORDER IN THE CASE SOLELY BECAUSE TRIAL COUNSEL WAS THE PARTY'S IN-HOUSE GENERAL COUNSEL DEPRIVED

THAT PARTY OF ITS CONSTITUTIONAL RIGHT TO COUNSEL OF ITS CHOICE UNDER THE FIFTH AND SIXTH AMENDMENTS.

Right to counsel in criminal cases is guaranteed by the Sixth Amendment and is also within the intendment of the due process of law clause of the Fifth Amendment, Powell v. Alabama, 287, U.S. 45, at Page 66, 53 S.Ct. 55, 77 L.Ed. 158 (1932). Right to counsel in civil cases is no less fundamental, McCuin v. Texas Power & Light Co., 714 F. 2D 1255 (5th Cir. 1983), at Page 1262. In McCuin, the Court stated at P. 1262 (citations omitted):

> Litigants do have a right to be represented by counsel and this ordinarily implies a right to lawyers of their choice. Counsel must be a member of the bar and must be admitted to practice before the court in which he appears. He must not have a conflict of interest with another party. His employment must not entail disclosure of confidential information. The choice is never completely unfettered.

In Brown Bag, the only issue involved the possible disclosure of confidential information. In the district court below, Brown Bag submitted "Plaintiff's Opposition to Defendants' Motion for Protective Order against Disclosure of Defendants' Source Code and Other Highly Confidential Information to Plaintiff's In-house Counsel," dated March 6, 1989. Exhibit A to Plaintiff's Opposition was a declaration in which Brown Bag's trial counsel/in-house general counsel agreed to abide by the Protective Order. He further agreed to retain the confidential information in a locked file cabinet to

which he had the only keys. On P. 2 of his declaration, counsel stated:

> I am neither an officer nor a director of Brown Bag, and I play no management role in the product positioning of Brown Bag. I began employment with Brown Bag only in mid-February, 1989. Insofar as I am aware, I am not related to any other person at Brown Bag.

Exhibit B to Plaintiff's Opposition was a declaration by the President of Brown Bag in which he stated that he had reviewed the Protective Order in the case and the obligations which the Protective Order placed on counsel of record. He said that neither he nor anyone else at Brown Bag not specifically authorized by the Protective Order would attempt to or actually gain access to the confidential information of Defendants/Respondents. Brown Bag's President stated that he would ensure that no one at Brown Bag interfered in any way with the obligations imposed by the Protective Order on in-house counsel.

Brown Bag's President further stated in his declaration that in-house counsel:

1. Was neither an officer nor a director of Brown Bag, and

2. Played no management role in the product positioning of Brown Bag, and

3. Began employment with Brown Bag only in mid-February 1989, and

4. Was not related to any other person at Brown Bag insofar as the President was aware.

The two leading cases involving disclosure of confidential information to in-house counsel under protective orders are U.S. Steel Corp. v. United States, 730 F.2d 1465 (Fed.Cir. 1984) and Matsushita Elec. Indus. Co. v. United States, 929 F.2d 1577 (Fed. Cir. 1991). The Matsushita court applied the U.S. Steel analysis. In both cases, there were both in-house counsel and retained/trial counsel. Thus, even if in-house counsel were to be denied access to the confidential information under the protective orders, retained/trial counsel would have access. In each case, in-house counsel was granted access to the confidential information under the protective order. In the instant case, the in-house counsel was also the trial counsel. Therefore, access to the confidential information was even more critical since there was no outside/trial counsel.

In U.S. Steel, the court stated at P. 1469:

> In further proceedings, access should be denied or granted on the basis of each individual counsel's actual activity and relationship with the party represented, without regard to whether a particular counsel is in-house or retained.

At P. 1468, the U.S. Steel court stated:

> Whether an unacceptable opportunity for inadvertent disclosure exists, however, must be determined, as above indicated, by the courts on a counsel-by-coun-

> sel basis, and cannot be determined solely by giving controlling weight to the classification of counsel as in-house rather than retained.

Again, at P. 1468, the U.S. Steel court stated:

> In a particular case, e.g., where in-house counsel are involved in competitive decision making, it may well be that a party seeking access should be forced to retain outside counsel or be denied the access recognized as needed.

In the Matsushita case, counsel who was granted access was General Counsel, Senior Vice President and Secretary at Tandy Corporation (P. 1579). At P. 1580, the Matsushita court stated:

> These findings are largely irrelevant, since the standard is not "regular contact" with other corporate officials who make "policy", or even competitive decisions, but "advice and participation" in "competitive decision making."

In Brown Bag, the magistrate in the district court stated in the "Order on Symantec's Motion for a Protective Order" at Page 2:

> Under the circumstances of this case in-house counsel is so close to the party that the dangers of inadvertent disclosure of the information is impossible to control.

Also on P. 2 of the Order, the Magistrate stated:

> The plaintiff has sought the removal of its outside counsel and has designated its new and sole in-house counsel as counsel of record in this case. Plaintiff's in-house counsel is the first and only in-house counsel for Brown Bag Software. His responsibilities run the gamut of legal issues from personnel to intellectual property. Although clearly not a management employee, in-house counsel's role is to advise management on all legal issues. He is also the corporation's Human Resource (personnel) person.

Thus, there is no evidence that counsel in the instant case is involved in competitive decision making. The Magistrate had reached a decision solely on the basis of counsel's position as in-house counsel and the general responsibilities of such a position. The appeals court below stated at P. 3728:

> For example, Brown Bag's counsel could not advise his employer on beta tester employment or other marketing strategies that might relate to information he had learned about Symantec's beta tester program or its development and promotion plans for GrandView.

Such a restriction would be acceptable. There was no evidence that counsel's duties would include providing such advice. If asked to provide such advice, counsel could have explained that he was bound by the Protective Order. Both Brown Bag's President and counsel had submitted the declarations described previously which stated that Brown Bag's in-house general counsel was not involved in product positioning. Brown Bag's President had also stated in his declaration that he would ensure that no one at Brown Bag

interfered in any way with the obligations imposed by the Protective Order on in-house counsel.

Brown Bag's counsel was an attorney admitted to practice in California and in Federal courts. He was bound by the same ethical obligations and rules of professional conduct as outside counsel. There was no basis to question trial counsel's ability to discharge his obligations under the Protective Order beyond the mere fact that trial counsel was Brown Bag's in-house general counsel.

Both Brown Bag's President and counsel had submitted the declarations described previously which stated that BROWN BAG'S IN-HOUSE GENERAL COUNSEL WAS NOT INVOLVED IN PRODUCT POSITIONING. There was no evidence that counsel was involved in competitive decision making or would disclose the confidential information during the course of his duties. In U.S. Steel, 730 F.2d at P. 1469, the court stated:

> The certified question (whether access may be granted to retained and denied to in-house counsel solely on a presumption that inadvertent disclosure by the latter is more likely) is answered in the negative, i.e., a denial of access sought by in-house counsel on the sole ground of their status as in-house counsel is error.

In the instant case, the appeals court below engaged in speculation at P. 3728 regarding possible involvement in competitive decision making even after both Brown Bag's counsel and Brown Bag's president submitted declarations

agreeing to protect the confidential information as required by the Protective Order and declaring that counsel played no role in product positioning.

The Magistrate's Order allowed an independent consultant to review and advise on issues involving the confidential documents. However, this was not a viable alternative. Trial counsel cannot effectively represent his client if shown only certain documents selected by a consultant. Trial counsel is responsible for effectively going forward with the client's case. To make informed decisions regarding case management, counsel must evaluate all aspects of a case to determine strengths and weaknesses. Since Respondents' trial counsel had access to all of Brown Bag's confidential documents under the Protective Order, the parties still would not have been on an equal footing. This does not consider the added cost to Brown Bag of paying the consultant. As it was, Brown Bag filed for bankruptcy protection.

Petitioner respectfully requests this honorable Court to recognize that in-house counsel and retained counsel are members of the same bar, subject to the same rules of professional conduct, and are to be judged by the same standards.

If this honorable Court returns this case to the trial court, Petitioner respectfully requests that discovery be reopened for a period of at least 90 days to return Brown Bag to an equal footing.

II. IN PERFORMING A COMPARISON OF TWO COMPUTER SOFTWARE PROGRAMS UNDER THE COPY-

RIGHT LAW TO DETERMINE IF THE TWO PROGRAMS ARE SUBSTANTIALLY SIMILAR, THE OVERALL "LOOK AND FEEL" OF THE TWO PROGRAMS SHOULD BE COMPARED, JUDGE LEARNED HAND'S ABSTRACTION SCALE SHOULD BE APPLIED TO THE IDEA/EXPRESSION DICHOTOMY AND BOTH LAY AND EXPERT OPINION SHOULD BE ALLOWABLE IN A SINGLE SUBSTANTIAL SIMILARITY INQUIRY.

The source of Congress' authority to enact copyright laws is the Constitution of the United States, Article I, Section 8, Clause 8. The copyright laws are found in 17 U.S.C. Section 101, et seq. Sections 101, 102 and 103 are of particular interest in the instant case.

Certiorari should be granted to correct the outcomes in the courts below and to standardize copyright law among the circuits as applied to computer software programs, particularly in the area of what has become known as "look and feel." Computer software has grown into a major industry and has become an important segment of the U.S. economy. Computer software is an important export. The courts have struggled to adapt copyright law to protect this important part of our economy. Leading edge developments have been taking place in the area of "look and feel."

In Johnson Controls v. Phoenix Control Systems, 886 F.2d 1173 (9th Cir.1989), the appeals court below stated at P.1175:

> Computer software is subject to copyright protection. 17 U.S.C. Section 101. A computer program is made up of several different components, including the source and object code, the structure, sequence and/or organization of the program, the user interface, and the function, or purpose, of the program. Whether a particular component of a program is protected by a copyright depends on whether it qualifies as an "expression" of an idea, rather than the idea itself. See Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 547, 105 S.Ct. 2218, 2223, 85 L.Ed.2d 588 (1985); Data East USA, Inc. v. Epyx, Inc., 862 F.2d 204, 207-08 (9th Cir. 1988); 17 U.S.C. Section 102(b). (Footnotes omitted.)

The omitted footnotes are as follows:

> The source code is a set of instructions to the computer, in languages such as BASIC, or FORTRAN. The object code is the same set of instructions, but in binary code, a series of 1's and 0's, which the computer reads.
>
> The user interface, also called the "look and feel" of the program, is generally the design of the video screen and the manner in which information is presented to the user.

The district court stated in Brown Bag at P. 1993:

> Copyright protection applies to the user interface, or overall structure and organization of a computer program, including its audiovisual displays or screen "look and feel." Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc., 797 F.2d 1222, 1234 [230 USPQ 481, 488-89] (3d Cir. 1986); Broderbund Soft-

ware v. Unison World, 648 F. Supp. 1127 [231 USPQ 700] (N.D. Cal. 1986).

Computer lawyer Douglas Derwin, Esq. stated in an article which appeared at P. 6 of The Recorder of March 19, 1990:

> . . . Jack Russo of Fenwick, Davis & West (now of Nelson & Russo) invented the concept of "look and feel" protection, which he defined as copyright protection over the manner in which a computer program appears to a user, including screen displays and the general manner in which the program operates.

The district court stated in Brown Bag at P. 1996:

> The allegedly infringing work encompasses the same idea and performs the same general function as plaintiff's PC-Outline.

The district court stated in Brown Bag at P. 1994: "The idea of a computer run outlining program is undisputedly identical in both GrandView and PC-Outline."

In Brown Bag, the appeals court affirmed the district court's method of "analytic dissection" and indicated that an evaluation of the "overall look and feel" was not required, Brown Bag at P. 3739. At P. 3737, the appeals court stated:

> Under the reformulated extrinsic test, we mean to perpetuate "analytic dissection" as a tool for comparing not only ideas but also expression. Thus, it was not error for the court to use "analytic dissection" in comparing the expressions of the two programs.

In Brown Bag, the district court stated at P. 1996:

> After redacting that material which is not protected under the copyright, or which has been licensed to Mr. Friend, the court performed the required extrinsic and intrinsic tests mandated by law.

Regarding the material which was licensed to Mr. Friend by means of the Purchase and Sale Agreement, that Agreement states at P. 6 and P. 7 that:

> Nothing in this Agreement will be construed as ... any implied right to use the "look and feel" of the Program...

Petitioner contends that the court should have applied a test which compared the "look and feel" of the two programs as a whole. In Atari, Inc. v. North American, Etc., 672 F. 2d 607 (7th Cir. 1982), the court stated at P. 614 and P. 615 concerning the ordinary observer test and analytic dissection:

> It has been said that this test does not involve "analytic dissection and expert testimony," Arnstein, 154 F.2d at 468, but depends on whether the accused work has captured the "total concept and feel" of the copyrighted work, Roth Greeting Cards v. United Card Co., 429 F. 2d 1106, 1110 (9th Cir. 1970).
>
> While dissection is generally disfavored, the ordinary observer test, in application must take into account that the copyright laws preclude appropriation of only those elements of the work that are protected by copyright. (Citations omitted.)

At P. 619 and P. 620, the Atari, Inc. court said:

> Based on an ocular comparison of the two works, we conclude that plaintiffs clearly showed likelihood of success. Although not "virtually identical" to PAC-MAN, K.C. Munchkin captures the "total concept and feel" of and is substantially similar to PAC-MAN.

At Page 618, the Atari, Inc. court said:

> When analyzing two works to determine whether they are substantially similar, courts should be careful not to lose sight of the forest for the trees. Hoehling, 618 F. 2d at 979-80.

Various elements may not be copyrightable, yet the unique combination of these elements may form copyrightable material. In Roulo v. Russ Berrie & Co., 886 F. 2d 931 (7th Cir. 1989), the court stated at P. 939:

> Berrie insists that the jury was allowed to consider elements of similarity unprotected by copyright laws, such as the size of the cards, the color of the paper, ink, and border designs, the general concept of stripes, the ellipses and the single-side format. While it is true that these elements are not individually capable of protection, just as individual words do not deserve copyright protection, it is the unique combination of these common elements which form the copyrighted material. The district court correctly instructed the jury by adopting the defendant's proposed instruction that the common elements noted above are not copyrightable, adding that "[t]he combination of these elements in an arrangement or layout is entitled to copyright protection, however, if you

find that arrangement or layout to be original and unique.

Sem-Torq,Inc. v. K Mart Corp.,936 F. 2d 851 (6th Cir. 1991), is a case involving compilations under 17 U.S.C. 103. The Sem-Torq court stated at P. 855:

> Sem-Torq's signs, then, may only be protected if the set is original. "A copyrightable compilation can consist mainly or entirely of uncopyrightable elements," Harper House, Inc. v. Thomas Nelson, Inc., 889 F. 2d 197, 204 (9th Cir. 1989), because "it is the unique combination of these common elements which form the copyrighted material," Roulo v. Russ Berrie & Co., 886 F. 2d 931,939 (7th Cir. 1989), cert. denied, ---U.S.---, 110 S. Ct. 1124, 107 L. Ed. 2d 1030 (1990); see also Sargent v. American Greetings Corp., 588 F. Supp. 912, 919 (N.D. Ohio 1984).

Thus, in comparing works as a whole, even the uncopyrightable elements are to be included in the comparison.

There are similarities between operating a program such as PC-Outline and operating a video game in that each has audiovisual displays, and each goes through a sequence as the operator interfaces with the program. In Atari Games Corp. v. Oman, 888 F. 2d 878 (D.C. Cir. 1989), the court said at P. 883::

> The Act, however, uses the definitional term "series of related images," 17 U.S.C. Sect. 101, and the case law correspondingly indicates that the Register's focus, even if initially concentrated on discrete parts, ultimately should be on the audiovisual work as a

whole, i.e., the total sequence of images displayed as the game is played.

In Stern Electronics, Inc. v. Kaufman, 669 F. 2d 852 (2nd Cir. 1982), the court said at P. 855 in discussing a "knock-off" that:

> ...replicates precisely the sights and sounds of the game's audiovisual display. This could be done by writing a new computer program that would interact with the hardware components of a video game to produce on the screen the same images seen in "Scramble," accompanied by the same sounds. Such replication is possible because many different computer programs can produce the same "results," whether those results are an analysis of financial records or a sequence of images and sounds. A program is simply "a set of statements [i.e., data] or instructions to be used directly or indirectly in a computer in order to bring about a certain result," Pub. L. No. 96-517, Sect. 10(a), 94 Stat. 3015, 3028 (1980) (amending 17 U.S.C. App. Sect. 101 (1976)). To take an elementary example, the result of displaying a "4" can be achieved by an instruction to add 2 and 2, subtract 3 from 7, or in a variety of other ways. Obviously, writing a new program to replicate the play of "Scramble" requires a sophisticated effort, but it is a manageable task.

In his article titled "Copyright at the School of Patent," University of Chicago Law Review, Volume 58, Number 1, Winter 1991, John Shepard Wiley Jr., Professor of Law, UCLA (hereinafter "Prof. Wiley") stated at P. 121:

> The most notorious problem in copyright law is the idea/expression dichotomy. The Supreme Court launched this doctrine more than a century ago. Congress codified it in 1976, making clear that it sought to restate rather than to alter, the judicial doctrine. (Footnotes omitted.)

In Harper & Row.Publishers v. Nation Enterprises, 471 U.S. 539, 85 L. Ed. 588, 105 S. Ct. 2218, this Court stated that copyright was limited to expression and not ideas. In Feist Pub. v. Rural Tel. Serv., 113 L. Ed. 358 (1991), this Court stated at P. 372:

> This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship.

Prof. Wiley, supra, states at P. 122:

> Although simple to recite, this basic rule is difficult to make concrete. In a telling omission, Congress failed to define the key terms "idea" and "expression." The leading judicial effort to give meaning to the terms is Judge Learned Hand's abstractions test...

Prof. Wiley, id., went on to quote Judge Hand from Nichols v. Universal Pictures Corp., 45 F. 2d 119 (2d Cir. 1930) at P. 121:

> Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at

> times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playright could prevent the use of his "ideas" to which, apart from their expression, his property is never extended.

The Conference Report, "LAST FRONTIER CONFERENCE ON COPYRIGHT PROTECTION OF COMPUTER SOFTWARE," Donald S. Chisum, Rochelle Cooper Dreyfuss, Paul Goldstein, Robert A. Gorman, Dennis S. Karjala, Edmund W. Kitch, Peter S. Menell, Leo J. Raskind, Jerome H. Reichman and Pamela Samuelson, ABA Jurimetrics Journal, Fall 1989, Volume 30, Number 1, states at P. 20:

> The Third Circuit's decision in Whelan Assocs. v. Jaslow Dental Labs., Inc., 797 F. 2d 1222 (1986), does not take all of these basic principles of copyright law into account. The court sought to implement the idea/expression distinction by making the idea coterminous with the "purpose" of the program. The opinion fails to provide more than an unduly restrictive conclusion about the idea/expression distinction, stating that "the purpose or function of a utilitarian work would be the work's idea, and everything that is not necessary to that purpose or function would be part of the expression." 797 F. 2d at 1236. In applying this test, the court defined the purpose of the plaintiff's program as the "efficient organization of a dental laboratory" and found that "there are a variety of program structures through which that idea can be expressed." 797 F. 2d at 1240. This approach employs an overly narrow interpretation of the term "idea" in Section 102(b) of the Copyright Act and omits systematic consideration of whether program similarities are unprotectible as "procedure, process, system,

> method of operation, concept, principle, or discovery." To the extent that the idea/expression distinction reflects a determination of the level of competition desirable in regard to the subject matter under consideration, as numerous courts have suggested, this formulation restricts competition more broadly than would be the case even in regard to traditional works of art and literature.

A similar result occurred in Brown Bag at P. 3739 of the appeals court's opinion below. The district court in Brown Bag stated at P. 1994:

> The idea of a computer run outlining program is undisputedly identical in both GrandView and PC-Outline.

While the district and appeals courts below followed Whelan, in Plains Cotton Co-op. v. Goodpasture Computer Serv., 807 F.2d 1256 (5th Cir. 1987), at P. 1262 the court declined to embrace Whelan. In his article titled "Software Engineering Practices and the Idea/Expression Dichotomy: Can Structured Design Methodologies Define the Scope of Software Copyright?," ABA Jurimetrics Journal, Fall 1991, Volume 32, Number 1, Richard Armstrong Beutel (hereinafter "Mr. Beutel") states at P. 18:

> Whelan's clearly very broad interpretation of the idea/expression dichotomy has been criticized extensively. Problems with Whelan's broad holding quickly emerged, and took specific form in the Fifth Circuit's subsequent decision in Plains Cotton Coop. Ass'n. v. Goodpasture Computer Serv., Inc. Founded

upon Judge Higgenbotham's opinion in Synercom Technology, Inc. v. University Computing Co., The Plains Cotton court declined to follow the broad holding of Whelan by reaffirming Judge Hand's "level of abstractions" test.

Mr. Beutel, id., states at P. 19:

> While the final judicial outcome of the split between the Third and Fifth Circuits is far from clear, most commentators side with the Fifth Circuit's narrower reading of the scope of software copyright. Most commentators take the view that the Third Circuit's rejection of the abstractions test is simplistic and unworkable, providing, as it does, a single identification of the unprotected idea (the end user application or function). (Footnotes omitted.)

Mr. Beutel, id., goes on to quote from Nimmer on Copyright, Section 13.03[F] (1991) at P. 13-78.33 and P. 13-78.34:

> The crucial flaw in [the reasoning of the Whelan court]...is that it assumes that only one "idea," in copyright law terms, underlies any computer program, and that once a separable idea can be identified, everything else must be an expression. All computer programs are intended to cause the computer to perform some function. The broad purpose that the program serves, be it managing a dental laboratory, automating a factory, or dispensing cash at a bank teller machine, is an idea. Other elements of the program's structure and design, however, may also constitute ideas for copyright purposes.

Further to the "levels of abstraction" analysis, Mr. Beutel, id., states at P. 20:

> Assuming the Fifth Circuit view prevails (despite obstacles posed by more recent cases such as Pearl Systems v. Competition Electronics), the "levels of abstractions" process should become the primary analytic vehicle for the parsing of software code into its protectible elements. Once the software has been parsed into its constituent "ideas" and "expressions," the courts may make a reasoned analysis under the "substantial similarity" requirement to determine if software copyright has been in fringed.
>
> At least two distinct methodologies have been proposed in the commentary defining an approach for the "level of abstractions" test to software code. Both approaches advocate a specific methodology in examining software to resolve the idea/expression dichotomy. The first, suggested by Mssrs. Bernacchi, Frischling, and Nimmer, involves the Successive Filtering of software code to eliminate unprotectible ideas. This "Successive Filtering" test screens software code at each level of abstraction to eliminate unprotectible expression. Central to this approach are the "filters" themselves, which are based upon several different copyright law doctrines clarifying the idea/expression dichotomy.
>
> The second approach, suggested by Gary Reback and David Hayes, advocates a "rule of reason" methodology under the "Abstractions Test." This Abstractions Test seeks to balance the creativity of the software author with the scope of the ensuing copyright monopoly.

Lotus Development Corp. v. Paperback Software Intl., 15 USPQ 2d (D. Mass. 1990), was a computer software copyright infringement action involving an electronic spreadsheet program. Spreadsheet programs, such as Lotus 1-2-3, and outlining programs, such as PC-Outline are similar in that both begin with essentially blank screens, and the users create spreadsheets or outlines in which the users insert their own information.

In Lotus, the court spent considerable effort attempting to distinguish between idea and expression and reviewed, at P. 1593, the attempt of Judge Learned Hand. The Lotus court stated the most significant elements of the legal test for copyrightability as:

> FIRST, in making the determination of "copyrightability," the decision maker must focus upon alternatives that counsel may suggest, or the court may conceive, along the scale from the most generalized conception to the most particularized, and choose some formulation - some conception or definition of the "idea" - for the purpose of distinguishing between the idea and its expression.
>
> SECOND, the decision maker must focus upon whether an alleged expression of the idea is limited to elements essential to expression of that idea (or is one of only a few ways of expressing the idea) or instead includes identifiable elements of expression not essential to every expression of that idea.
>
> THIRD, having identified elements of expression not essential to every expression of the idea, the decision

maker must focus on whether those elements are a substantial part of the allegedly copyrightable "work."

The Lotus court went on to state at P. 1599:

> The fact that some of these specific command terms are quite obvious or merge with the idea of such a particular command term does not preclude copyrightability for the command structure taken as a whole. If particular characteristics not distinctive individually have been brought together in a way that makes the "whole" a distinctive expression of an idea -- one of many possible ways of expressing it -- then the "whole" may be copyrightable.

In Brown Bag,, the district court below stated at P. 1995:

> Inherent in the idea of an outlining program is the need to access existing files, edit the work, and print the work. These concepts are fundamental to a host of computer programs. Nevertheless, plaintiffs assert that the presence of these four options in the menu screen demonstrates substantial similarity of expression. This expression is unprotectable.

Thus, the district court in Brown Bag did not look at the command structure as a whole as did the Lotus court which stated (see above) that characteristics not distinctive individually may be brought together in a way that makes the "whole" a distinctive expression of an idea.

The Lotus court considered menus at P. 1599:

> This particular expression of a menu structure is not essential to the electronic spreadsheet idea, nor does it merge with the somewhat less abstract idea of a menu structure for an electronic spreadsheet. The idea of a menu structure -- including the overall structure, the order of commands in each menu line, the choice of letters, words, or "symbolic tokens" to represent each command, the presentation of these symbolic tokens on the screen (i.e., first letter only, abbreviations, full words, full words with one or more letters capitalized or underlined), the type of menu system used (i.e., one-,two-, or three-line moving-cursor menus, pull-down menus, or command-driven interfaces), and the long prompts -- could be expressed in a great many if not literally unlimited number of ways.

In Brown Bag, the district court below stated at P. 1995:

> Apparently, plaintiff is also asserting the use of pull down windows as a similarity. This idea is employed in a number of computer programs, including MORE! and ThinkTank. Plaintiffs may not claim copyright protection of an idea and expression that is, if not standard, then commonplace in the computer software industry. Plaintiff's copyright validly covers only "original works of authorship." (Citations omitted.)

Concerning its program comparison test and the use of expert witnesses, the appeals court below in Brown Bag stated at P. 3733 and P. 3744:

> In this court's leading copyright infringement case, we held that, in assessing the similarity of two works, expert testimony is appropriate in some respects and inappropriate in others. Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F. 2d 1157, 1164 (9th Cir. 1977). Initially, the line was drawn between comparing ideas embodied in a work, for which expert testimony was appropriate, and comparing the works' respective expressions of common ideas, for which expert testimony was thought inappropriate. Id. Recently, however, we have recognized that the line is more properly drawn between objective and subjective analyses of expression. Shaw v. Lindheim, 919 F. 2d 1353, 1357 (9th Cir. 1990). As such, expert opinion is relevant not only to the analysis of ideas behind two works but also to the objective analysis of expression.

Yet, in Brown Bag at P. 3734, the appeals court below stated that the district court had considered the declaration of Brown Bag's expert, Mr. Ronald Ogg ("Mr. Ogg"), to the full extent permitted under our circuit's law. In the instant case, the district court stated in Footnote 3 on P. 1994 that Mr. Ogg's declaration, which contained expert opinion as to the similarity of the two programs, would not be admitted.

Mr. Ogg's declaration, executed on May 3, 1989, states on P. 3 and P. 4:

> Even a brief comparison of THINKTANK and GRANDVIEW shows that the user interface of GRANDVIEW is not derived in any significant way from THINKTANK. Among a long litany of differences which could be identified, the shades of blue

used are different, no menu bar is used, the bulk of the commands are different, and no support for multiple outline windows is possible. In my opinion, no reasonable person could conclude that THINKTANK and GRANDVIEW have a substantially similar "look and feel", as that term is used in the context of computer software.

However, PC OUTLINE and GRANDVIEW have extremely similar user interfaces, and have virtually the same look and feel. Moreover, a number of the features common between PC OUTLINE and GRANDVIEW are unique to these two programs, and no other program has so similar a combination of features which make up the user interface. Virtually every function performed by PC OUTLINE is also performed by GRANDVIEW, often in a virtually identical way. Where the steps used to perform the feature differ in GRANDVIEW, the change seems to be primarily cosmetic. It is correct that GRANDVIEW offers features additional to those offered by PC OUTLINE; however, this would be expected in any program derived from an earlier program, and does not conflict with my opinion that GRANDVIEW is substantially similar to PC OUTLINE, at least as to the look and feel of the user interface. Stated differently, in my opinion the look and feel of GRANDVIEW is substantially similar to and was derived from the look and feel of PC OUTLINE.

In addition, a newspaper article, attached to the declaration of Brown Bag's President which was submitted in association with summary judgment, gave the author's comparison of the "look and feel" of PC-Outline and Grand-

View. The appeals court below stated at P. 3734 of its decision in Brown Bag:

> Brown Bag also contends that the district court rejected the declaration of Sanford B. Schupper, Brown Bag's president. Symantec and Friend objected to the admission of exhibits of newspaper articles attached to Schupper's declaration. The district court did not rule on Symantec's and Friend's objection. Neither did it reference Schupper's declaration or the exhibits in its order granting summary judgment. On this record, Brown Bag can point to no rejection or denial of the affidavit to appeal.

In Arnstein v. Porter, 154 F.2d 464, the court stated at P. 468:

> If there is evidence of access and similarities exist, then the trier of the facts must determine whether the similarities are sufficient to prove copying. On this issue, analysis ("dissection") is relevant, and the testimony of experts may be received to aid the trier of the facts.
>
> If copying is established, then only does there arise the second issue, that of illicit copying (unlawful appropriation). On that issue (as noted more in detail below) the test is the response of the ordinary lay hearer; accordingly, on that issue, "dissection" and expert testimony are irrelevant. (Footnote omitted.)

In Whelan Associates v. Jaslow Dental Laboratory, 797 F.2d 1222 (3rd Cir. 1986), the court stated at P. 1232 and P. 1233:

The district court heard expert testimony. See supra 1228; infra at 1246-48. It did not bifurcate its analysis, however, but made only a single finding of substantial similarity. See Whelan Associates v. Jaslow Dental Laboratory, 609 F.Supp. at 1321-22. It would thus appear to have contravened the law of this circuit. Nevertheless, for the reasons that follow, we believe that the district court applied an appropriate standard.

The ordinary observer test, which was developed in cases involving novels, plays, and paintings, and which does not permit expert testimony, is of doubtful value in cases involving computer programs on account of the programs' complexity and unfamiliarity to most members of the public.

Moreover, the distinction between the two parts of the Arnstein test may be of doubtful value when the finder of fact is the same person for each step: that person has been exposed to expert evidence in the first step, yet she or he is supposed to ignore or "forget" that evidence in analyzing the problem under the second step. Especially in complex cases, we doubt that the "forgetting" can be effective when the expert testimony is essential to even the most fundamental understanding of the objects in question.

On account of these problems with the standard, we believe that the ordinary observer test is not useful and is potentially misleading when the subjects of the copyright are particularly complex, such as computer programs. We therefore join the growing number of courts which do not apply the ordinary observer test in copyright cases involving exceptionally difficult materials, like computer programs, but instead adopt

a single substantial similarity inquiry according to which both lay and expert testimony would be admissible.

Prof. Wiley, supra, states at P. 129:

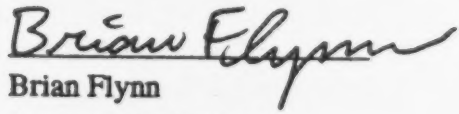
A second core problem in the law of copyright concerns the use of expert opinion in infringement cases. The variety of judicial attitudes is remarkable. Some courts demonstrate absolutely no interest in either highlighting or limiting the use of expert opinion. Other courts banish experts altogether. Still other courts set forth involved and separate roles for expert and lay opinions, even while disagreeing with each other about the definition of these roles. To complete the circle, other courts defer completely to expert opinion on the matter of copyright infringement. Yet for all this diversity of attitude, the cases offer no understanding of the consequences at stake or the considerations that ought to control.

CONCLUSION

For these reasons, a writ of certiorari should issue to review the judgment and opinion of the Court of Appeals in this matter. Petitioner respectfully requests attorney's fees for this appeal pursuant to 17 U.S.C. 505 and costs. Petitioner further respectfully requests that that the costs assessed by the district and appeals courts below be reversed.

Dated: June 25, 1992

Respectfully Submitted,



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NOTE: The page numbers of the foregoing cite differ from those of the printed opinion of the appeals court below which is included in the Appendix.

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APPENDIX A

Opinion, United States Court of Appeals for the Ninth Circuit (April 7, 1992) [Brown Bag Software V. Symantec Corp. and John L. Friend, an individual and dba Softworks Development, 92 Daily Journal D.A.R. 4680 (9th Cir. 1992)]

NOTE: Page numbers in this Appendix A are those of the court's published opinion and differ from those of the foregoing Daily Journal cite.

FOR PUBLICATION

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

BROWN BAG SOFTWARE, a California corporation, formerly Telemarketing Resources, Inc.,
Plaintiff-Appellant,

v.

SYMANTEC CORP., a California corporation; JOHN L. FRIEND, an individual and dba Softworks Development,
Defendants-Appellees.

No. 89-16239

D.C. No. CV-88-20352-RPA

OPINION

Appeal from the United States District Court
for the Northern District of California
Robert P. Aguilar, District Judge, Presiding

Argued and Submitted
February 14, 1991—San Francisco, California

Filed April 7, 1992

Before: Joseph T. Sneed, Thomas Tang and David R. Thompson, Circuit Judges.

Opinion by Judge Tang; Concurrence by Judge Sneed

SUMMARY

Courts and Procedure/Intellectual Property

Affirming in part, vacating in part and remanding a district court grant of summary judgment on a copyright infringe-

ment, the court of appeals held that the district court had properly issued a protective order restricting the access of appellant's in-house counsel to confidential trade information produced during discovery.

Appellant Brown Bag Software sued Symantec Corp. and John L. Friend for infringement of Brown Bag's registered copyright in a computer program for outlining. The district court granted Symantec's motion for a protective order restricting the access of Brown Bag's in-house counsel to the documents labelled "attorneys' eyes only" under the parties' previous stipulation. However, the order provided that Brown Bag could have access only through an "independent consultant," legal or otherwise. The district court granted summary judgment for Symantec.

[1] In this case, the court had to balance the risk to Symantec of inadvertent disclosure of trade secrets to competitors against the risk to Brown Bag that protection of Symantec's trade secrets impaired prosecution of its claims. [2] Proper review of protective orders in cases such as this required the factual examination of all the risks and safeguards surrounding inadvertent disclosure by any counsel, whether in-house or retained. In addition, the nature of the claims and of a party's opportunity to develop its case through alternative discovery procedures factors into decisions on the propriety of such protective orders. [3] Here, a magistrate reasonabley concluded that Brown Bag's counsel's employment would necessarily entail advising his employer in areas relating to Symantec's trade secrets. [4] In addition, the magistrate weighed not only the risk of disclosure to Symantec, but also the potential impairment of Brown Bag's case against Symantec. Thus, the magistrate adequately considered the hardship a protective order might impose on Brown Bag's prosecution of its claims. [5] Brown Bag's assertion that the protective order unfairly hindered its opposition to summary judgment was too speculative to establish that the protective order was an abuse of discretion. Brown Bag failed to show

how the protective order actually could have or did prejudice its case.

[6] Summary judgment for a defendant accused of copyright infringement is appropriate when the plaintiff fails to show a genuine issue regarding whether the ideas and expressive elements of the works are substantially similar. [7] In assessing the similarity of two works, expert testimony is appropriate in some respects and inappropriate in others. [8] Here, the district court relied on a disputed affidavit to identify objective components for comparison. The district court therefore considered the declaration of Brown Bag's expert to the full extent permitted under Ninth Circuit law. In addition, Brown Bag failed to establish that the district court's decision not to credit the opinion expressed in the affidavit more fully prejudiced Brown Bag.

[9] Brown Bag was entitled to a presumption of originality in its computer outline copyright because it was registered. [10] Brown Bag's argument that the district court erred in holding this presumption rebutted was meritless. [11] In addition, it was not error for the district court to use "analytic dissection" in comparing the expressions of the two computer programs in question. [12] Analytic dissection is used not for the purposes of comparing similarities and identifying infringement, but for the purpose of defining the scope of plaintiff's copyright. [13] Because the district court found that Brown Bag made no showing of similarity with regard to copyrighted components of the computer outline program, summary judgment was not precluded by *Shaw*.

[14] Although the district court dismissed Brown Bag's pendent state claims because it had granted summary judgment to Symantec and Friend on its federal claims, the district court's order did not even mention the Lanham Act claim. [15] The court refused to infer a district court's decision on an entire claim and to rewrite the trial court's judgment to include the inferred decision. Thus, the court remanded the

Lanham Act claim for clarification and determination by the district court.

Judge Sneed concurred separately in Parts I and III of the court's opinion, and in the judgment regarding Part II. Judge Sneed believed that *Shaw* provides a poor analytic strucure by which to determine the substantial similarity of an allegedly infringing computer program.

COUNSEL

Brian Flynn, Sunnyvale, California, for the plaintiff-appellant.

Gary L. Reback, Fenwick, Davis & West, Palo Alto, California, for the defendants-appellees.

OPINION

TANG, Circuit Judge:

Brown Bag Software ("Brown Bag") sued Symantec Corp. ("Symantec") and John L. Friend for infringement of Brown Bag's registered copyright in a computer program for outlining. The district court entered a protective order restricting the access of Brown Bag's in-house counsel to confidential trade information produced during discovery. The district court subsequently granted Symantec's and Friend's motions for summary judgment. Brown Bag appeals the protective order and the grant of summary judgment. We affirm-in-part, vacate-in-part and remand.

FACTUAL AND PROCEDURAL BACKGROUND

In 1983, Symantec developed and marketed the first successful outlining program, "ThinkTank." By 1985, Symantec

had developed and marketed two more outlining programs, "Ready!" and "MORE," each designed for different types of computer hardware.

John L. Friend is an independent computer program designer, doing business as "Softworks Development." Friend designed a new outlining program called "PC-Outline," a program he said was "inspired by" Symantec's ThinkTank program. Friend stated he "borrowed" several of ThinkTank's features for PC-Outline.

In April 1987, Friend sold PC-Outline to Brown Bag. As part of the purchase agreement, Friend warranted that he was not then developing a program that would infringe Brown Bag's newly acquired copyright in PC-Outline. In return, Brown Bag granted Friend a "non-exclusive right" to use 129 pages of computer source code.[1]

Also in 1987, Friend developed and sold an outlining program called "Grandview" to Symantec. Symantec marketed the new program as an updated version of its ThinkTank and MORE programs. Under the terms of the sale, Friend retained custody of Grandview's source code.[2]

On June 8, 1988, Brown Bag sued Symantec and Friend in federal district court. Brown Bag alleged that Symantec's

---

[1]"The list of commands written by the programmer is known as *source code* and is typically readable by those conversant in the programming language ("C," BASIC, PASCAL, FORTRAN, etc.). The source code is converted by a program known as a [compiler] into the binary zeros and ones — the *object code* or machine language — to be run by the computer." Wallace Walter, *It Does Not Compute*, Legal Times, June 17, 1991, (Supplement), at 50, 51-52.

[2]To the extent that property rights in the source code exist apart from other aspects of Grandview, ownership of the source code is unclear. Friend declared that while a copy of the code was delivered to Symantec, Symantec may only look at the code "under certain conditions of default under our agreement, none of which has occurred."

Grandview infringed Brown Bag's copyright and trademark rights in PC-Outline, in violation of federal law. Brown Bag also alleged several pendent state law claims.

At the beginning of the suit, outside counsel represented Brown Bag. Counsel for all parties stipulated to measures designed to protect Symantec's and Friend's trade secrets divulged in discovery. These trade secrets included the source code for Grandview, developmental plans for Grandview, and the identities of "beta testers," consumer representatives upon whom Symantec market-tested different versions of Grandview. The parties' stipulation restricted access to these materials to "attorneys' eyes only."

On February 17, 1989, Brown Bag's retained counsel withdrew, and Brown Bag's newly hired in-house counsel entered his appearance on behalf of Brown Bag. Symantec moved for a protective order restricting the access of Brown Bag's in-house counsel to the documents labelled "attorneys' eyes only" under the parties' previous stipulation.

On March 8, 1989, after an evidentiary hearing, a magistrate issued an order preventing Brown Bag's in-house counsel from directly viewing the documents. The order provided for Brown Bag's access only through an "independent consultant, legal or otherwise." Specifically, the protective order envisioned an outside consultant hired by Brown Bag who would review the "attorneys' eyes only" documents and advise Brown Bag regarding their relevance. As the magistrate stated at the hearing, "if [it] is the opinion of the outside consultant that in house counsel needs [certain] material in order to pursue the litigation, then there has to be a very specific request, item by item, back to the court for the items that are deemed to be necessary." The magistrate thus did not rule out the possibility of some disclosure of sensitive documents to Brown Bag's in-house counsel.

On April 4 and 5, 1989, Symantec and Friend moved for summary judgment. On April 24, 1989, the district court

denied Brown Bag's motion for reconsideration of the magistrate's protective order and for extension of the discovery period. On April 28, 1989, Symantec filed a motion to strike the two declarations Brown Bag had filed in opposition to summary judgment. The district court did not separately rule on these motions.

After the May 5 summary judgment hearing, the district court requested supplementary "letter briefs" from all parties. Symantec's counsel submitted its letter brief on May 11 on behalf of both Symantec and Friend. Brown Bag also submitted its letter brief on May 11. On May 19, Friend filed a "supplemental declaration in support of summary judgment."

On May 24, 1989, the district court granted summary judgment to Symantec and Friend. The court subsequently entered an "Amended Order" granting summary judgment to Symantec and Friend, and dismissing Brown Bag's state law claims. *Telemarketing Resources v. Symantec Corp.*, 12 U.S.P.Q.2d (BNA) 1991 (N.D. Cal. 1989). Brown Bag timely appeals the protective order and summary judgment.

DISCUSSION

I. *Access of Brown Bag's In-House Counsel to Trade Secrets Divulged in Discovery*

This court reviews a district court's rulings concerning discovery for an abuse of discretion. *Ah Moo v. A.G. Becker Paribas, Inc.*, 857 F.2d 615, 619 (9th Cir. 1988).

Rule 26(c) of the Federal Rules of Civil Procedure explicitly authorizes the district court to protect parties from "undue burden or expense" in discovery by ordering "that a trade secret or other confidential research, development, or commercial information not be disclosed or be disclosed only in a designated way." The parties agree that source codes, development plans, and beta tester information (all of which Sym-

antec produced to Brown Bag's retained outside counsel under protective stipulation) constitute protectable trade secrets under Rule 26(c). Brown Bag contests, however, the court order requiring Brown Bag to retain an "independent consultant" to view those trade secrets. Brown Bag contends that the court should have permitted its in-house counsel immediate and direct access to those trade secrets.

[1] We have not previously determined when protective orders for trade secrets may be appropriate. The issue entails conflicting interests. On the one hand, parties seeking discovery are entitled to all information "reasonably calculated to lead to the discovery of admissible evidence," Fed. R. Civ. P. 26(b)(1) — an intentionally broad mandate. On the other hand, responding parties are entitled to protection from "undue burden" in discovery, including protection from misuse of trade secrets by competitors. Fed. R. Civ. P. 26(c). These conflicting interests suggest that a balancing test will best resolve protective order disputes such as the one here. Specifically, in this case we must balance the risk to Symantec of inadvertent disclosure of trade secrets to competitors against the risk to Brown Bag that protection of Symantec's trade secrets impaired prosecution of Brown Bag's claims.

According to Brown Bag, preventing its in-house counsel from immediate and direct access to the trade secrets in question also prevents Brown Bag from exercising its due process rights to select counsel and to prosecute its claims. Brown Bag contends that the district court arbitrarily distinguished between outside counsel, whom the court permitted access to the trade secrets, and in-house counsel, whom it denied direct access under the protective order. Brown Bag argues further that the protective order resulted in Brown Bag's inability to oppose summary judgment adequately because in-house counsel's examination of the trade secrets might have produced evidence supporting Brown Bag's opposition.

We turn to *U.S. Steel Corp. v. United States*, 730 F.2d 1465 (Fed. Cir. 1984), as the leading authority on protective orders

distinguishing between outside and in-house counsel. *See also Matsushita Elec. Indus. Co. v. United States*, 929 F.2d 1577, 1579 (Fed. Cir. 1991) (applying *U.S. Steel* analysis). The *U.S. Steel* court cautioned against arbitrary distinctions based on type of counsel employed, noting that in practice the risk of inadvertent disclosure of trade secrets obtains equally for both kinds of counsel. 730 F.2d at 1468. The *U.S. Steel* court concluded that, to evaluate the risk of inadvertent disclosure, a court should examine the factual circumstances of *any* counsel's relationship to the party demanding access. *Id.* A crucial factor in the *U.S. Steel* case was whether in-house counsel was involved in "competitive decisionmaking"; that is, advising on decisions about pricing or design "made in light of similar or corresponding information about a competitor." *Id.* at 1468 n.3.

[2] Thus, proper review of protective orders in cases such as this requires the district court to examine factually all the risks and safeguards surrounding inadvertent disclosure by *any* counsel, whether in-house or retained. Further, the nature of the claims and of a party's opportunity to develop its case through alternative discovery procedures factors into decisions on the propriety of such protective orders. Brown Bag and amicus American Corporate Counsel Association contend that the magistrate failed to perform just such a factual inquiry before crafting the protective order in this case.

The record belies this contention. The magistrate in fact held a comprehensive evidentiary hearing prior to issuing the protective order. At the hearing, Symantec's counsel described the extreme sensitivity of the trade secrets at issue. Symantec's counsel further described the potential damage to Symantec should the trade secrets inadvertently become subject to misuse by Symantec's competitor, Brown Bag. Brown Bag's counsel did not dispute the dangers inadvertent disclosure posed to Symantec. Instead, Brown Bag's counsel reassured the magistrate that the professional integrity of in-house counsel and his promise to store the trade secret documents in

a locked file cabinet in his Brown Bag office sufficiently protected Symantec from inadvertent disclosure.

The magistrate expressly credited in-house counsel's integrity and good faith. The magistrate had to consider, however, not only whether the documents could be locked up in cabinets, but also whether Brown Bag's counsel could lock-up trade secrets in his mind, safe from inadvertent disclosure to his employer once he had read the documents. As the *U.S. Steel* court suggested, the magistrate therefore inquired into counsel's responsibilities as Brown Bag's sole legal advisor and personnel manager. Brown Bag's counsel stated that he was hired just a few weeks prior to the hearing, that he was one of thirteen or fourteen employees, and that he did not yet know the duties of fellow employees. Brown Bag's counsel agreed that he was responsible for advising his employer on a gamut of legal issues, including contracts, marketing, and employment.

[3] From this testimony, the magistrate reasonably concluded that Brown Bag's counsel's employment would necessarily entail advising his employer in areas relating to Symantec's trade secrets. Knowledge of Symantec's trade secrets would place in-house counsel in the "untenable position" of having to refuse his employer legal advice on a host of contract, employment, and competitive marketing decisions lest he improperly or indirectly reveal Symantec's trade secrets. For example, Brown Bag's counsel could not advise his employer on beta tester employment or other marketing strategies that might relate to information he had learned about Symantec's beta tester program or its development and promotion plans for Grandview. Brown Bag's in-house counsel was thus involved in the kind of "competitive decisionmaking" that counsels against disclosure under the *U.S. Steel* analysis.

[4] Further, the magistrate weighed not only the risk of disclosure to Symantec, but also the potential impairment of

Brown Bag's case against Symantec. The evidentiary hearing revealed that, before in-house counsel appeared for Brown Bag, Brown Bag's former outside counsel had already had over six months in which to study the trade secrets. Brown Bag knew of the court-ordered deadline for summary judgment motions, and had had ample time to develop any admissible evidence it could from the trade secrets divulged to it. Further, none of the trade secrets were themselves relevant to Brown Bag's "look and feel" infringement claim, a claim dependent on comparison of the two published programs. Pursuant to Federal Rule of Civil Procedure 26(b), Brown Bag's counsel argued at the hearing that review of the trade secrets might "lead to the discovery of admissible evidence." Speculation as to what Brown Bag might discover in the future, however, was irrelevant because the deadline for discovery had passed. And, in any event, the magistrate provided means by which Brown Bag's in-house counsel could have obtained access to essential documents. Thus, the magistrate adequately considered the hardship a protective order might impose on Brown Bag's prosecution of its claims.

In sum, the record reveals that the magistrate inquired into the specific factual circumstances of Symantec's and Brown Bag's conflicting interests. The resulting protective order strikes a reasonable balance between those interests by shielding Brown Bag's in-house counsel from personal knowledge of a competitor's trade secrets, but allowing access to information through an independent consultant. The order did not arbitrarily distinguish outside and in-house counsel. Rather, in reaching its decision, the court considered the particular circumstances of Brown Bag's counsel then before it. The same considerations could have applied equally to outside counsel.

[5] Finally, Brown Bag's assertion that the protective order unfairly hindered its opposition to summary judgment is too speculative to establish that the protective order was an abuse of discretion. We stress that Brown Bag failed to demonstrate how the protective order actually could have or did prejudice

its case. Brown Bag never attempted to implement the independent consultant method of access to the trade secrets and never argued the method was unduly burdensome. Instead, Brown Bag alleged its unfettered right to the discovery documents and complained of arbitrary discrimination against in-house counsel. Brown Bag's arguments are unsubstantiated. We therefore hold that the court did not abuse its discretion in issuing the protective order.

II. *Summary Judgment on Brown Bag's Copyright Infringement Claim*

Brown Bag refrains from contending that a disputed issue of fact precluded summary judgment on its copyright infringement claim. Instead, Brown Bag identifies several alleged errors of law it believes entitle it to reversal of summary judgment. We review the summary judgment de novo. *Narell v. Freeman*, 872 F.2d 907, 909 (9th Cir. 1989).

To establish a copyright infringement claim, Brown Bag must show that it owns a valid copyright in PC-Outline and that Symantec and Friend copied protected elements of the program. *Narell*, 872 F.2d at 910. Brown Bag's ownership of a valid copyright in PC-Outline is undisputed. To establish the copying element of the claim, Brown Bag intended to show that Symantec and Friend had access to PC-Outline and that relevant portions of Grandview are substantially similar to those portions of PC-Outline in which Brown Bag owns a copyright. *See id.* Because Symantec also concedes that access is not at issue, the defendant's motion for summary judgment focused on Brown Bag's allegations of substantial similarity.

[6] Summary judgment for a defendant accused of copyright infringement is appropriate when the plaintiff fails to show a genuine issue regarding whether the ideas and expressive elements of the works are substantially similar. *Frybarger v. International Business Machs. Corp.*, 812 F.2d

525, 528 (9th Cir. 1987). This is so because the plaintiff bears the burden of proving that the allegedly infringing work is substantially similar to the work protected by plaintiff's copyright. *Id.* A "genuine issue" exists when the plaintiff provides indicia of "a sufficient disagreement" concerning the substantial similarity of two works "to require submission to a jury." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52 (1986); *see id.* at 248-52.

In response to the summary judgment motion brought by Friend and Symantec, Brown Bag submitted the declarations of its president, Sanford B. Schupper, and its computer expert, Ronald Ogg. The Ogg declaration set forth seventeen specific features in PC-Outline and Grandview alleged to be similar. *See Telemarketing Resources*, 12 U.S.P.Q.2d (BNA) at 1994-95. "[U]sing [Ogg's] list as a tool to organize the features which plaintiff asserts are substantially similar in the two programs," *id.* at 1994 n.3, the district court found that none of the listed features could form the basis for a finding of copyright infringement. *Id.* at 1995-96.

In particular, the district court ruled that one group of features represented a claim of copyright in "concepts . . . fundamental to a host of computer programs" such as "the need to access existing files, edit the work, and print the work." *Id.* at 1995. As such, these features, which took the form of four options in the programs' opening menus, were held to be unprotectable under copyright. *Id.*

A second group of features involved "nine functions listed in the menu bar" and the fact that "virtually all of the functions of the PC-Outline program[ ] can be performed by Grandview." *Id.* The district court declared that "these functions constitute the idea of the outlining program" and, furthermore, "[t]he expression of the ideas inherent in the features are . . . distinct." *Id.* The court also held that "the similarity of using the main editing screen to enter and edit data

. . . . is essential to the very idea of a computer outlining program." *Id.*

The third group of features common to PC-Outline and Grandview concerned "the use of pull down windows." *Id.* Regarding these features, the district court made three separate rulings. The court first found that "[p]laintiffs may not claim copyright protection of an . . . expression that is, if not standard, then commonplace in the computer software industry." *Id.* Second, the district court ruled that defendants had rebutted the presumption of originality attaching to Brown Bag's registered copyright in PC-Outline's use of pull-down windows, so that there was no copyright in this feature. *Id.* The court supported this finding with Friend's admission that he had based PC-Outline on ThinkTank. *Id.* Finally, the court concluded that the pull-down windows of the two programs look different. *Id.*

Regarding the color schemes of the two programs, the lower court noted that "[p]laintiff admits that fewer than 10 of the 44 default color selections in the [G]randview program are the same as the default color selections in the PC-Outline program." The court also rejected the similar blue backgrounds as a basis for finding infringement, citing functionality, a rule of the Copyright Office, and a decision of this court. *Id.* at 1995-96.

Regarding a fifth group of features, the district court concluded that any resemblance here was the permissible result of Friend's exercise of his rights under the license granted by Brown Bag as part of Friend's sale of PC-Outline to Brown Bag. *Id.* at 1996.

With regard to these five groups of features, the district court concluded that "many of the expressions which plaintiff argues are substantially similar are either not protected under the copyright or were licensed to Mr. Friend." *Id.* Thus, the

court ruled, "[p]laintiff may not rely on these features in proving its case at trial." *Id.*

Finally, regarding the two screens presenting the programs' respective opening menus, the court ruled that "the expression[s] of the two screens are not substantially similar, as a matter of law." *Id.* Finding that "[p]laintiff has failed to meet its evidentiary burden on this matter," the district court granted Symantec's summary judgment motion. *Id.*

Brown Bag attacks the district court's decision on four grounds. First, Brown Bag asserts that the district court wrongly rejected two affidavits it submitted in opposing summary judgment. Second, Brown Bag argues that Friend's supplemental declaration supporting summary judgment should not have been considered. Next, the plaintiff contends the district court erred in holding that Symantec had rebutted the presumption of originality adhering in the use of pull-down windows in PC-Outline. Finally, Brown Bag challenges the legal analysis used by the lower court to determine that no genuine issue existed regarding substantial similarity between the two programs. We reject each of these contentions.

A. *Refusal to Consider Brown Bag's Affidavits*

Symantec objected to Brown Bag's submission of Ronald Ogg's affidavit in opposition to summary judgment because Brown Bag had not disclosed Ogg as an expert witness in response to interrogatories. Brown Bag argues that the district court should have considered Ogg's expert opinion. The district court did use the list of program features contained in Ogg's affidavit to perform its analytic dissection. 12 U.S.P.Q.2d (BNA) at 1994 n.3. The court did not, however, consider Ogg's opinion itself. *Id.*

[7] In this court's leading copyright infringement case, we held that, in assessing the similarity of two works, expert testimony is appropriate in some respects and inappropriate in

others. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977). Initially, the line was drawn between comparing ideas embodied in a work, for which expert testimony was appropriate, and comparing the works' respective expressions of common ideas, for which expert testimony was thought inappropriate. *Id.* Recently, however, we have recognized that the line is more properly drawn between objective and subjective analyses of expression. *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990). As such, expert opinion is relevant not only to the analysis of ideas behind two works but also to the objective analysis of expression. *See id.*[3]

[8] Here, the district court relied on the disputed Ogg affidavit to identify objective components for comparison. The district court therefore considered the declaration of Brown Bag's expert to the full extent permitted under our circuit's law. Furthermore, Brown Bag failed to establish that the district court's decision not to credit Ogg's opinion more fully prejudiced Brown Bag.

Brown Bag also contends that the district court rejected the declaration of Sanford B. Schupper, Brown Bag's president. Symantec and Friend objected to the admission of exhibits of newspaper articles attached to Schupper's declaration. The district court did not rule on Symantec's and Friend's objection. Neither did it reference Schupper's declaration or the exhibits in its order granting summary judgment. On this record, Brown Bag can point to no rejection or denial of the affidavit to appeal. Even if the district court somehow erred in failing to consider Schupper's declaration, moreover, such error was harmless. Brown Bag has not argued how consideration of Schupper's declaration would have changed the result reached by the district court.

[3]Ninth Circuit law thus appears to be moving toward the test favored by Judge Sneed in his separate concurrence in which lay and expert testimony are uniformily admissible.

B. *Consideration of Friend's Supplemental Declaration*

Brown Bag contends that the district court relied on Friend's supplemental declaration in determining that various features common to both PC-Outline and Grandview were not protected by Brown Bag's copyright. Friend submitted the declaration after the summary judgment hearing and eight days after the district court's deadline for supplementary "letter briefs." Friend had previously joined Symantec's letter brief. Brown Bag argues that the untimeliness of Friend's declaration and the district court's reliance on it deprived Brown Bag of its due process right to respond.

We review a district court's evidentiary rulings for an abuse of discretion. *Roberts v. College of the Desert*, 870 F.2d 1411, 1418 (9th Cir. 1988). Reversal requires a showing of prejudice. *Id.* The district court here did not abuse its discretion by considering the Friend declaration. Brown Bag did not object to the declaration before the district court, nor has it argued on appeal that the declaration was inaccurate. If the declaration prejudiced Brown Bag, Brown Bag should have asserted that concern to the district court.

C. *Rebuttal of Presumption of Originality*

[9] Brown Bag was entitled to a presumption of originality in its PC-Outline copyright because the copyright was registered. *See Johnson Controls v. Phoenix Control Systems*, 886 F.2d 1173, 1175 (9th Cir. 1989). The district court held that Symantec and Friend rebutted this presumption of originality in PC-Outline's pull-down menus by showing that ThinkTank and other Symantec programs used pull-down menus prior to the development of PC-Outline. Brown Bag argues that, under the *Johnson Controls* case, the district court erred in this holding.

[10] Brown Bag's argument is meritless because the *Johnson Controls* case upon which Brown Bag relies does not

apply here. In *Johnson Controls*, defendant contended that plaintiff's copyrighted program was not original because "there are similar programs in use by other companies." 886 F.2d at 1175. We held that this assertion "is insufficient to rebut the presumption [of originality] in the absence of any evidence that [the plaintiff] copied from these other programs." *Id.*

In contrast, here Friend specifically stated that ThinkTank inspired his design of both PC-Outline and Grandview. The district court therefore had evidence from which it could reasonably infer that Friend copied the use of pull-down menus from ThinkTank. In any event, the district court provided two alternative grounds on which it denied copyright protection to Brown Bag's use of pull-down menus. The plaintiff challenges neither of these alternatives on appeal.

D. *Legal Analysis of Substantial Similarity*

In the *Krofft* case, we established a two-part test for substantial similarity. 562 F.2d at 1164. Under the original formulation of *Krofft*'s "extrinsic" component, a plaintiff needed to prove only the "similarity of ideas" in the two programs. *Id.* Today, however, the extrinsic test looks at more than just the similarity of ideas. As the district court understood, the extrinsic analysis is " 'an objective test which rests upon specific criteria that can be listed and analyzed.' " 12 U.S.P.Q.2d at 1994 (quoting *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 208 (9th Cir. 1988)). The extrinsic test thus has become an "objective . . . analys[is] of *expression*." *Shaw*, 919 F.2d at 1357 (original emphasis); *see also* 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.03[E][3], at 13-78.19 to -78.20 (1991) (hereinafter, "Nimmer") (discussing reformulation of *Krofft* analysis achieved in *Shaw*).

To establish infringement of a copyright, the two works in question must also meet the second component of the test set forth in *Krofft*, the "intrinsic test." 562 F.2d at 1164. The

intrinsic test, according to *Krofft*, should measure "substantial similarity in expressions . . . depending on the response of the ordinary reasonable person. . . .[I]t does not depend on the type of external criteria and analysis which marks the extrinsic test." *Id.* (citations omitted). In applying the intrinsic test, therefore, "analytic dissection and expert testimony are not appropriate." *Id.*

Brown Bag contends that the district court misapplied the intrinsic test because the court improperly performed "analytic dissection" in comparing the expressions of ideas embodied in the two programs. Indeed, the district court explicitly performed "analytic dissection," comparing specific screens, menus, and keystrokes, in part to detect substantial similarity. 12 U.S.P.Q.2d (BNA) at 1995-96. The court performed the dissection at Brown Bag's behest and in response to a list of allegedly substantially similar features Brown Bag proffered in opposition to summary judgment.

[11] Brown Bag's argument ignores the evolution of the "extrinsic" component of the *Krofft* analysis. Properly understood, the district court's analysis was not a misapplication of the "intrinsic test," but a proper application of the revised "extrinsic test." Under the reformulated extrinsic test, we mean to perpetuate "analytic dissection" as a tool for comparing not only ideas but also expression. Thus, it was not error for the district court to use "analytic dissection" in comparing the expressions of the two programs. Specifically, the district court properly compared the expressions embodied in the two screens presenting the programs' respective opening menus. *See* 12 U.S.P.Q.2d (BNA) at 1996.

[12] The district court's analytic dissection of the five groups of features involving unprotected or unprotectable work was also proper, but for an entirely diffe nt reason. This analysis had nothing to do with assessing substantial similarity, and therefore was not subject to the old limitations *Krofft* imposed on the use of analytic dissection. Instead, as

to these groups, the district court applied analytic dissection for the purpose of determining "whether similarities [between the programs] result from unprotectable [or unprotected] expression." *Data East*, 862 F.2d at 208. In this application, analytic dissection is used not for the purposes of comparing similarities and identifying infringement, but for the purpose of defining the scope of plaintiff's copyright.

This point bears emphasis. Analytic dissection is relevant not only to the copying element of a copyright infringement claim, but also to the claim's ownership element. One aspect of the ownership element is the copyrightability of the subject matter and, more particularly, the scope of whatever copyright lies therein. *See* Nimmer § 13.01[A]. To the extent a plaintiff's work is unprotected or unprotectable under copyright, the scope of the copyright must be limited. *See, e.g., Data East*, 862 F.2d at 209 (holding that, because "the similarities result from unprotectable expression," "[t]he lower court erred by not limiting the scope of [plaintiff's] copyright protection").[4] Thus, where two works are found to be similar without regard to the scope of the copyright in the plaintiff's work, *Data East* teaches that the source of the similarity must be identified and a determination made as to whether this source is covered by plaintiff's copyright. It is this process in which the district court engaged with regard to the five groups of features found to be unprotected or unprotectable by Brown Bag's copyright in PC-Outline. Again, this use of analytic dissection was proper.

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[4]The degree to which unprotected or unprotectable features must be eliminated from a comparison of two works is difficult to say. Although copyright protection is not afforded to certain elements of a work, such limitations "must not obscure the general proposition that copyright may inhere, under appropriate circumstances, in the selection and arrangement of unprotected components." Nimmer § 13.03[F][5], at 13-78.44 n.342; *accord Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 111 S. Ct. 1282, 1289, 1294 (1991); *see* Nimmer § 13.03[F][5], at 13-78.45 n.345 (discussing Ninth Circuit cases).

Brown Bag further argues that the district court became so engrossed in its analytic dissection that it neglected to evaluate the "overall look and feel" of the two programs for substantial similarity. Stated differently, Brown Bag contends that the district court failed to consider the "intrinsic" component of the *Krofft* test, which involves a subjective analysis of similarities in expression. *See Shaw*, 919 F.2d at 1357. Even assuming this is true, we find no reversible error because the record fails to include any evidence indicating that Brown Bag requested the district court to make this analysis. Although the district court "entertained an in-court demonstration of the two programs and . . . carefully reviewed submitted copies of relevant outlining programs," 12 U.S.P.Q.2d (BNA) at 1992, no such evidence was ever included as part of Brown Bag's opposition to Symantec's summary judgment motion. Therefore, there is no reason we should expect the district court to have made the analysis Brown Bag now requests.

Finally, Brown Bag argues that, because PC-Outline and Grandview shared a common idea — specifically the idea of an outlining program — summary judgment is precluded by our decision in *Shaw*. We held in *Shaw* that "satisfaction of the extrinsic test creates a triable issue of fact in a copyright action involving a literary work." 919 F.2d at 1359.

In response, Symantec argues we should distinguish *Shaw* from the instant case on the basis that the *Shaw* rule applies by its own terms only to literary works. We decline to distinguish *Shaw* for that reason, however, because at least some computer programs bear significant similarities to literary works. On the scant record available to us in this case, we cannot conclude as a matter of law that the programs at issue here, or computer programs in general, are so nonliterary or so limited in their variety of expression as to avoid application of the rule announced in *Shaw*.

We nevertheless reject Brown Bag's argument on the basis that it misapprehends the nature of the "extrinsic" test follow-

ing *Shaw*. If the rule in *Shaw* was applied without recognizing that the extrinsic test now includes some analysis of expression, *Shaw* would ring "the death-knell in the Ninth Circuit for defense summary judgments based on purported absence of substantial similarity." Nimmer § 13.03[E][3], at 13-78.20. But, as we have discussed, after *Shaw* the extrinsic test examines not only similarity of ideas, but also objective similarity of expressions.

[13] In particular, the extrinsic test for literary works requires analytic dissection of several "objective components of expression," *Shaw*, 919 F.2d at 1361, within a literary work such as plot, theme, characters, and dialogue. *Id.* at 1356-57. Similarity of these objective components in two literary works logically gives rise to a triable issue of similarity. *Id.* at 1357. Likewise, computer programs are subject to a *Shawtype analytic dissection of various standard components, e.g.*, screens, menus, and keystrokes. Because the district court found that Brown Bag made no showing of similarity along these lines with regard to copyrighted components of PC-Outline, summary judgment was not precluded by the rule announced in *Shaw*. *See also* Nimmer § 13.03[E][3], at 13-78.20 ("given *Shaw*'s reformulation of the extrinsic test, the decision is better viewed as standing for the unremarkable proposition that when objectively speaking a triable case of expressive similarity exists, the case must be sent to the trier of fact; but when no such objective argument is possible, summary judgment will lie.") (footnotes omitted).[5]

III. *Brown Bag's Federal Trademark/Trade Dress Claim*

In its complaint, Brown Bag alleged two federal claims, copyright infringement and "false designation of origin," a

[5]The federal copyright act authorizes the award of attorney's fees and costs to the prevailing party. 17 U.S.C. § 505. Anticipating reversal of summary judgment, Brown Bag requests its fees and costs. We deny the request.

violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). For its Lanham Act claim, Brown Bag alleges that "Defendants ... falsely promote Grandview as being an upgrade, derivative or improvement upon PC-Outline in a manner to suggest a connection with [Brown Bag] .... There is a likelihood of confusion, mistake or deception."[6] [Complaint at 9, ER at F.]

[14] The district court dismissed Brown Bag's pendent state claims because it had granted summary judgment to Symantec and Friend on Brown Bag's federal claims. The district court's order granting summary judgment does not even mention the Lanham Act claim, however. If the district court intended to grant summary judgment on the Lanham Act claim as well, its order granting summary judgment on the infringement claim presents no rationale for it. On this record, it appears that the district court intended to dispose of all federal claims on summary judgment, but overlooked the Lanham Act claim.

Symantec argues that we should infer the district court intended to grant summary judgment on the Lanham Act claim and affirm that judgment on the basis of the record. In support of its motion for summary judgment, Symantec informed the district court that there was "no evidence that Symantec or its agents falsely promoted Grandview ... in [a]

[6]The claim which Brown Bag alleges is a Lanham Act false designation of origin claim, distinguishable from a "reverse passing off" claim. In a "reverse passing off" claim under the Lanham Act, a defendant markets a copied product as its own. *See Shaw*, 919 F.2d at 1364. A reverse passing off claim is therefore dependent upon a successful infringement claim. *Id.* (declining to recognize reverse passing off claims in all events). Because Brown Bag alleged in its complaint a false designation of origin claim, however, Brown Bag need not have shown that Symantec and Friend infringed Brown Bag's copyright in PC-Outline in order to state a claim under the Lanham Act that Symantec and Friend falsely promoted Grandview as an updated version of PC-Outline. Summary judgment on Brown Bag's copyright infringement claim, therefore, did not compel summary judgment on its Lanham Act claim.

manner as to suggest a connection with [Brown Bag]." In response, Brown Bag failed to offer any evidence pertaining to the Lanham Act claim, and therefore failed to carry its evidentiary burden in opposing summary judgment. *See* Fed. R. Civ. P. 56(c); *Shaw*, 919 F.2d at 1359. Because the evidence of record is one-sided in favor of Symantec, Symantec argues that we should infer and affirm the district court's summary judgment for Symantec on the Lanham Act claim.

[15] Symantec's argument is pragmatic, assuring as it would a final end to the litigation given that Brown Bag's other claims of error are without merit. Symantec asks this court, however, to infer a district court's decision on an entire claim and to rewrite a district court judgment to include the inferred decision. We decline to take such liberties with a district court's intentions and judgments. Instead, we conclude that it was Symantec's and Friend's responsibility to clarify the district court's judgment and to save themselves needless litigation over a possible oversight. We therefore remand the Lanham Act claim for such clarification and for further proceedings as the district court deems necessary in light of our opinion.

IV. *Friend's Notice of Joinder in Symantec's Appellate Brief*

Symantec's and Friend's appellate briefs were due in this court July 25, 1990. Symantec submitted its brief on that date. On July 30, 1990, Friend filed a "Notice of Joinder in Brief of Appellee Symantec." Brown Bag moved this court to strike Friend's notice as untimely and to reverse summary judgment as to Friend for his failure to oppose the appeal. Brown Bag cited no authority for its requested action. Neither Friend nor Symantec responded to Brown Bag's motion.

The only sanction authorized by the Federal Rules of Appellate Procedure for an appellee's failure to file a timely brief is refusal to hear the appellee at oral argument. Fed. R.

App. P. 31(c). The limited nature of this sanction coincides with our duty to affirm the judgment on any ground fairly supported by the record. *See Wabol v. Villacrusis*, 908 F.2d 411, 424 n.22 (9th Cir. 1990); *United States v. Bergmann*, 836 F.2d 1220, 1223 (9th Cir. 1988). Because Brown Bag appealed the judgment for Friend, and because the record supports judgment for Friend even in the absence of his joinder or briefing, we affirm judgment for Friend as well as for Symantec. We therefore perceive no prejudice to Brown Bag in permitting Friend's joinder, although we by no means condone untimely filings. Accordingly, the motion to strike is denied.

CONCLUSION

The protective order limiting Brown Bag's access to Symantec's trade secrets struck a reasonable balance between the parties' interests. We affirm that order as a proper exercise of discretion. The record fails to support Brown Bag's objections to summary judgment on its copyright infringement claim. We therefore affirm that judgment for both Symantec and Friend. The record does not support an inference that the district court granted summary judgment on the Lanham Act claim, however. We therefore remand that claim for further proceedings consistent with this opinion.

The judgment of the district court is AFFIRMED-IN-PART and VACATED-IN-PART, and the case is REMANDED.

SNEED, Senior Circuit Judge, Concurring Separately:

I concur in Parts I and III of Judge Tang's opinion, and in the judgment with respect to Part II.

My difference as to Part II is rooted in my belief that *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990), provides a poor

analytic structure by which to determine the substantial similarity of an allegedly infringing computer program. This is a message already dispatched by District Judge Orrick of the Northern District of California in *Broderbund Software Inc. v. Unison World Inc.*, 648 F. Supp. 1127, 1136 (1986). He preferred Circuit Judge Becker's approach in *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987). That approach was described by Judge Orrick as "an integrated substantial similarity test pursuant to which both lay and expert testimony would be admissible." *Broderbund*, 648 F. Supp. at 1136.

I remain convinced, however, that even were we to travel the road pointed to by Judge Orrick, we would end up precisely where we now are. The trip would be unnecessary; therefore, I concur in the result reached in Part II.

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APPENDIX B

Final Judgment, United States District Court for the Northern District of California (San Jose) [Telemarketing Resources, Inc. V. Symantec Corp. and John L. Friend, an individual dba Softworks Development, 12 U.S.P.Q. 2d (BNA) 1991 (N.D. Cal. 1989)]

DISTRICT COURT, N.D. CALIFORNIA

Telemarketing Resources v. Symantec Corp.

No. C 88-20352 RPA

Decided September 6, 1989

COPYRIGHTS

1. NON-COPYRIGHTABLE MATTER - IDEAS AND SYSTEMS (§ 211.05)

PROTECTABILITY OF COMPUTER PRODUCTS - IN GENERAL (§ 225.01)

Use of opening "menu" in computer program is idea and thus not protectable.

2. NON-COPYRIGHTABLE MATTER - IDEAS AND SYSTEMS (§ 211.05)

PROTECTABILITY OF COMPUTER PRODUCTS - IN GENERAL (§ 225.01)

Functions in computer software program to facilitate creation and editing of outlines, such as opening or starting new outline, accessing existing outline, accessing directory, and quitting program altogether, are inherent in idea of outlining program and are not protected under copyright.

3. RIGHTS IN COPYRIGHT; INFRINGEMENT -RIGHT TO REPRODUCTION IN COPIES OR PHONORECORDS - ACCESS, COPYING AND SUBSTANTIAL SIMILARITY (§213.0503)

PROTECTABILITY OF COMPUTER PRODUCTS - INFRINGEMENT (§ 225.07)

Accused opening screen, for computer software program to facilitate creation and

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editing of outlines, shares similar ideas with plaintiff's opening screen but is not substantially similar.

Action by Telemarketing Resources against Symantec Corp., and John L. Friend, d/b/a Softworks Development, for copyright infringement. On defendants' motion for summary judgment. Motion granted.

Limbach, Limbach & Sutton, San Francisco; Brian Flynn, Campbell, Calif., for plaintiff.

William F. Abrams and Paul Warner, of Jeffer, Mangels & Butler, San Francisco; Fenwick, Davis & West, Palo Alto, Calif., for defendants. AGUILAR, J.

AMENDED ORDER GRANTING
SUMMARY JUDGMENT MOTION

I.

The Court is called upon to decide whether the "look and feel" of the screen displays in defendants' computer outlining program are substantially dissimilar from plaintiff's copyrighted program so as to justify a grant of summary judgment. Towards this end, the Court must decide which elements of the computer program are ideas and which are protected expressions.

In addition to the briefs and supplemental papers filed on the summary judgment motion, the Court entertained an in-court demonstration of the two programs and has carefully reviewed submitted copies of relevant outlining programs. Good cause appearing therefor, the Court HEREBY GRANTS the motion for summary judgment for the reasons set out below.

II. FACTUAL BACKGROUND

A. Computer Outlining Programs

In 1983, Living Videotext, now a division of defendant Symantec, developed one of the premier computer outlining programs - "ThinkTank." Like most computer adaptions of everyday tasks, a computer outliner allows a user to create, revise, expand and reorganize an outline more quickly than can be done on paper. The program has two components - the computer code and the resulting displays on the computer screen.

Since 1983, Symantec has published several enhanced versions of ThinkTank and a series of increasingly more powerful outlining programs - "Ready!", "More" and "Grandview." The ThinkTank program was designed to run on IBM compatible computers. The user interface features included menus listing available commands and options, the ability to use function keys to perform tasks, and to translate regular keys to function keys when in a special mode.

The "More" program was developed for Apple's Macintosh computer. The program contained many of the distinc-

tive graphical interface features associated with Apple computer programs, and included pull down menus and both overlapping and tiled windows. Defendants argue that menu names coined for MORE were later included in Grandview.

"Grandview" is the latest computer outlining program offered by Symantec and was developed by defendant John L. Friend. Friend's first computer outlining program was PC-Outline, which he states was inspired by ThinkTank. Friend, doing business as Softworks, sold PC-Outline to plaintiff, Brown Bag Software. Because at the time of the sale, Friend was already working on the program which became Grandview, the Purchase and Sale Agreement contained the following clause:

> Software warrants and represents that it is not currently developing any computer program which would infringe the copyright rights to be assigned to TRI pursuant to this Agreement.

In addition, Friend was granted the right to use "the non-application- specific libraries and routines set forth in Exhibit C." Exhibit C consists of 129 pages of source code. Defendant Friend argues that the features of Grandview which plaintiff contends infringe the PC-Outline copyright were assigned to Friend pursuant to the Purchase and Sale Agreement. The assigned source code draws a menu bar at the top of the screen, draws the bar with one of the options highlighted, which can then be pulled down into a menu. Other routines draw the single line border around the menus

and windows as well as drawing the message line at the bottom of the screen.

When Symantec bought Friend's program, it required extensive reprogramming and format changes, allegedly to bring the new program into line with More and ThinkTank. The goal was to make Grandview appealable to users of More and ThinkTank.

Plaintiffs allege that Grandview is substantially similar to PC-Outline and actually an infringing derivative work of the copy-

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righted program. Defendants contend that the alleged infringing features are unprotected ideas, not expressions.

III. LEGAL STANDARDS

A. Summary Judgment

The Court must review the copyright claims, in light of the summary judgment attack, to determine whether plaintiffs have come forward "with specific facts showing that there is a genuine issue of material fact" to support the allegations of the complaint as to the defendants. Fed.R.Civ.P. 56(c); Matsushita Electrical Industrial Co. v. Zenith Radio, et al., 475 U.S. 574, 587, 106 S.Ct. 1348, 1356 (1986); Celotex v. Catrett, 477 U.S. 317, 106 S.Ct. 2548 (1986). There is no issue for trial unless there is sufficient evidence favoring the plaintiffs for a jury to return a verdict

for them. Anderson v. Liberty Lobby, 477 U.S. 242, 106 S.Ct. 2505, 2516 (1986). "A party opposing a properly supported motion for summary judgment may not rest upon mere allegation or denials of his pleading, but must set forth specific facts showing that there is a genuine issue for trial, supported by evidentiary material beyond the pleadings. Celotex, 477 U.S. at 324. "If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted." Anderson, 477 U.S. at 249-250 (cites omitted). Plaintiff must meet his burden of proof in rebutting the summary judgment motion.

"Because plaintiff bears the burden of proving that the works are substantially similar in a copyright infringement case, summary judgment for defendant is appropriate when plaintiff fails to make a sufficient showing that the ideas and expressive elements of the works are substantially similar" Frybarger v. IBM Corp., 812 F.2d 525, 528 [2 USPQ2d 1135, 1137] (9th Cir. 1987).

B. Copyright Protection And Computer Programs

Copyright protection applies to the user interface, or overall structure and organization of a computer program, including its audiovisual displays, or screen "look and feel." Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc. 797 F.2d 1222, 1234 [230 USPQ 481, 488-89] (3d Cir. 1986); Broderbund Software v. Unison World, 648 F.Supp. 1127 [231 USPQ 700] (N.D. Cal. 1986).[1] In this case, defendants do not contest the copyrightability of computer screens in general, but argue that the functions which plaintiffs point to

as evidence of copying are ideas and hence not protected. In addition, John L. Friend asserts his license to use the source code which generates the alleged similarities.

To prevail on a claim for copyright infringement, plaintiff must prove ownership of the copyright and copying by the defendant. Copying by the defendant, in turn, may be shown by circumstantial evidence of access to the copyrighted work and substantial similarity between the copyrighted work, PC-Outline, and the allegedly infringing work, Grandview. Sid & Marty Krofft Television v. McDonald's Corp., 562 F.2d 1157, 1162 [196 USPQ 97, 101] (9th Cir. 1977); Baxter v. MCA, Inc., 812 F.2d 421, 423 [2 USPQ2d 1059, 1061] (9th Cir. 1987), cert. denied, _____U.S._____, 108 S.Ct. 346 (1987). In this case, there is no dispute over the copyright ownership or access to PC-Outline. The only disputed issue is whether or not there is substantial similarity in the expression of the idea of a computer outlining program.

However, the classic distinction between an idea and an expression serves to limit the scope of a copyright. "No one infringes, unless he descends so far into what is concrete as

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[1] *Computer generated screens for video games were found copyrightable as audiovisual works in Kramer Mfg. Co. v. Andrews, 783 F.2d 421 [228 USPQ 705] (4th Cir. 1986) and Williams Electronics v. Artic International, 685 F.2d 870 [215 USPQ 654] (3rd Cir. 1982). Digital Communications v. Softklone Dist., 659 F.Supp. 449 [2 USPQ2d 1385] (N.D. Ga. 1987) decided that a status screen for a computer program was subject to copyright protection as a compilation.*

to invade ... [its] expression." Sid and Marty Krofft, 562 F.2d at 1163 [196 USPQ at 101], citing National Comic Publications v. Fawcett Publications, 191 F.2d 594, 600 [90 USPQ 274, 278] (2d Cir. 1951); See also Baker v. Selden, 101 U.S. 99, 103 (1879). In addition, the courts have developed what is known as the merger doctrine, if an idea is indistinguishable or inseparable from, or limited by, its expression, "copying the expression will not be barred." Herbert Rosenthal Jewelry v. Kalpakian, 446 F.2d 738, 742 [170 USPQ 557, 559-60] (9th Cir. 1971); Data East v. Epyx, 862 F.2d at 208 [9 USPQ2d 1322 at 1325-26]; Aliotti v. R. Dakin & Co., 831 F.2d 898 [4 USPQ2d 1869] (9th Cir. 1987); NEC Corp. v. Intel Corp., 10 USPQ2d 1177, 1179 (N.D. Cal.

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1989). See also Morrisey v. Procter & Gamble Co., 379 F.2d 675 [154 USPQ 193] (1st Cir. 1967).[2]

Furthermore, if the underlying idea is subject to a limited range of expression, copyright protection would apply only "against virtually identical copying." Frybarger v. IBM, 812 F.2d at 530 [2 USPQ2d at 1138-39]; NEC v. Intel, 10 USPQ2d at 1188.

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[2]*In NEC v. Intel, Judge Grey held that the issue of merger and the relationship between idea and expression applies to the issue of infringement rather than copyrightability.*

Finally, copyright protection is not "afforded to elements of expression that necessarily follow from an idea" and are "'as a practical matter, indispensable or at least standard in the treatment of a given [idea].'" Data East v. Epyx, 862 F.2d at 208 [9 USPQ2d at 1325-26] (quoting Alioti, 831 F.2d at 901 [4 USPQ2d at 1871]).

Substantial similarity is established by first applying an "extrinsic" test to determine whether two ideas are similar. "This is an objective test which rests upon specific criteria that can be listed and analyzed." Data East v. Epyx, 862 F.2d at 208 [9 USPQ2d at 1325]; Sid & Marty Krofft, 562 F.2d at 1164 [196 USPQ at 102-03]. If the ideas are similar, the expression of the idea is compared under an intrinsic, subjective test "which depends on the response of the ordinary reasonable person." Data East, 862 F.2d at 208 [9 USPQ2d at 1325]; Sid & Marty Krofft, 562 F.2d at 1164 [196 USPQ at 102-03].

IV. A COMPARISON OF THE TWO PROGRAMS

The idea of a computer run outlining program is undisputedly identical in both Grandview and PC-Outline. However, defendants also describe many of the features which plaintiff seeks to protect as ideas inherent within a computer outlining program.

Plaintiff asserts that the following aspects of Grandview's user interface are substantially similar to PC- Outline. These similarities allegedly render the total look and feel of the two programs substantially similar.[3]

a. Both present an opening menu labeled "OPENING MENU."

b. Both opening menus are enclosed in a single line box and appear in contrasting color to the rest of the title screen.

c. A reverse video cursor o highlighting bar" appears over the options on both menus. The user moves the highlighting bar with the cursor arrows and presses the enter key to select an option.

d. In both programs, as an alternative to using the highlighting bar, the user can select any option by hitting the capitalized letter for that option.

e. Both opening menus have the same four options, although Grandview adds three more.

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[3]*The list of alleged similarities is drawn from the declaration of Mr. Ronald Ogg and plaintiff's memorandum of points and authorities. Defendants object to the submission of Mr. Ogg's declaration. Mr. Ogg's declaration, which contains expert opinion as to the similarity of the two programs, will not be considered by the Court. Nevertheless, the Court is using the list as a tool to organize the features which plaintiff asserts are substantially similar in the two programs. In any event, the programs themselves supersede and control any contrary opinion, allegations or descriptions submitted by the parties. See Nimmer on Copyright, 12-73 § 12.10; Decorative Aides Corp. v. Staple Sewing Aides Corp., 497 F.Supp. 154 [218 USPQ 657] (S.D.N.Y. 1980).*

f. Both programs permit a new outline to be begun from the opening menu. The user must enter a filename for the new outline and the program then displays a main editing screen.

g. Both programs permit the selection of an existing outline. The outline list is pulled down and the user selects an outline with the arrow and enter keys.

h. Both editing screens have file, cursor location and window information across the top of the screen. Both use pull down menus, and display a list of the available menus on a "menu bar" across the top of the screen. A help line is on the bottom of the screen. Both programs have a line around the screen. Plaintiffs also assert similarities in the color scheme of the programs.

i. The main editing screens are used to edit and enter new data in both programs.

j. A new outline element is entered by pressing the enter key while holding down the control key in both programs. The new element may be dragged around if no text is added.

k. Pull down menus are selected by first pressing a "menu attention" key. (In Grandview, the default menu attention key is the f10 key, in PC-Outline either the insert or "/" key is used as the menu attention key.)

l. Once the menu attention key is pressed, the initial letter of each of the menus is highlighted. The word MENU is also displayed at the right end of the menu bar.

m. A menu is selected by either pressing the highlighted initial letter for the desired menu, or moving the cursor across the screen to the desired menu. The menu is displayed in reverse video in a pull down window.

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n. The form of the menu window is the same in both programs, inasmuch as it is surrounded by a single line border with a reverse video highlighting bar which is moved up and down with the arrow keys. A highlighted option is selected by pressing the enter key. Alternatively, a user can select an option by typing the appropriate code letter, usually the first letter of the option. The codes are displayed at the left of the menu as single, uppercase letters.

o. In both programs, certain of the commands displayed on the pull down menus may be directly selected from the main editing screen through the use of special combinations of keys.

p. Both programs offer nine pull down menus. Of those nine, four of the menu description words are identical, the other five are different, but the functions are the same or similar.

q. Finally, plaintiffs note that "virtually every function performed by PC-Outline is also performed by Grandview."

"Analytic dissection" of plaintiff's alleged similarities may be performed to determine if the similarities result from unprotectable expression. Data East, 862 F.2d at 208 [9

USPQ2d at 1325]; Aliotti v. R. Dakin, 831 F.2d at 900-901 [4 USPQ2d at 1871].

Inherent in the idea of an outlining program is the need to access existing files, edit the work, and print the work. These concepts are fundamental to a host of computer programs. Nevertheless, plaintiffs assert that the presence of these four options in the menu screen demonstrates substantial similarity of expression. This expression is unprotectable.

Plaintiff similarly asserts that the nine functions listed in the menu bar, and virtually all of the functions of the PC-Outline program, can be performed by Grandview, even though they may be called something different and accessed differently. However, these functions constitute the idea of the outlining program, for example, Grandview has a "Reorganize" menu and PC-Outline has an "Outline" menu. Both menus perform similar functions associated with reorganizing the outline. In addition, PC-Outline allows you to delete and create new entries when in the "Outline" menu. As a comparison, Grandview offers four move functions compared to the single move function available in this menu on PC-Outline.

A review of the various nine menus available in each of the programs leads to the conclusion that the features/functions on PC-Outline and Grandview are similar in their essence, but quite different in their complementary features. The expression of the ideas inherent in the features are accordingly distinct.

Apparently, plaintiff is also asserting the use of pull down windows as a similarity. This idea is employed in a number of computer programs, including MORE! and Think-Tank. Plaintiffs may not claim copyright protection of an idea and expression that is, if not standard, then commonplace in the computer software industry. Plaintiff's copyright validly covers only "original works of authorship." 17 U.S.C. § 102(a); Roth Greeting Cards v. United Card Co., 429 F.2d 1106 [166 USPQ 291] (9th Cir. 1970). Originality although not defined by statute, requires independent creation, it means "only that the work owes its origin to the author, i.e., is independently created." Nimmer on Copyright, 2-8.1 § 2.01[A]. Although a presumption of originality attaches to a valid copyright registration, defendants have rebutted this presumption in this case. John L. Friend testified that he based his PC-Outline on ThinkTank. In light of the use of pull-downs in previous programs, plaintiff has failed to show that the pull down windows were original and independently created for PC- Outline.

In addition, the pull down windows look different. The lists in each menu are different. Although the two programs share the use of letter abbreviations as a means of selecting the desired option, the wording describing the functions are dissimilar.

Plaintiff cites the similarity of using the main editing screen to enter and edit data. The need to have a screen from which a user can perform editing functions is essential to the very idea of a computer outlining program. Brown Bag points to the expression of that concept as similar inasmuch as the

color shading is identical. Plaintiff admits that fewer than 10 of the 44 default color selections in the Grandview program are the same as the default color selections in the PC-Outline program. Nevertheless, plaintiff asserts that the choice of the blue background infringes on the PC-Outline copyright. Defendant submitted declarations from an expert describing the functional role of the blue background "relating to the physiology of the human eye, the characteristics of the computer video displays and the connotations of the color blue for financial and corporate institutions." The Rules of the Copyright Office also specifically exclude from copyright registration "typographic ornamentation, lettering or coloring." 37 C.F.R. § 202.1. Finally, the limited number of

12 USPQ2d 1996

background colors for computer programs precludes copyright protection for such choices. United States v. Hamilton, 583 F.2d 448, 451 [200 USPQ 14] (9th Cir. 1978).

The Court finds that it is unnecessary to review the alleged similarities in the drawing of the menu bar, the use of highlighting bars and the use of a single line box around the menus because these features are covered in the license agreement between plaintiff and John L. Friend.

[1] The Court's "analytic dissection" of plaintiff's alleged similarities shows that the majority of the alleged similarities pertain to features that are not protected under the copyright. However, plaintiff also spent considerable time pointing out the similarities between the two programs' open-

ing menus, beginning with the title, "opening menu." The use of an opening menu, named an opening menu, is itself an idea and not protectable. Nevertheless, once the ideas are found to be similar, the Court must review the expression of that idea on the screen.

[2] At first glance, the screen's announcements are quite distinct. Grandview's name is portrayed in large, block letters at the top of the screen. "Welcome to PC-Outline" is modestly placed at the top of plaintiff's program. The list of the opening menu options are quite distinct. Grandview offers seven options, PC-Outline offers four. Some of the functions are the same, opening or starting a new outline, accessing an existing outline, accessing the directory and quitting the program altogether. Nevertheless, these functions are inherent in the idea of a computer outlining program and are not protected under the copyright. The description of these functions is different. Additionally, Grandview allows the user to access the functions by hitting a key letter or by highlighting the function.

[3] The Court may issue summary judgment on the issue of substantial similarity if it finds that no reasonable jury could find "substantial similarity of both ideas and expression between the works at issue." Aliotti, 831 F.2d at 900 [4 USPQ2d at 1870]. The two screens share the same idea, they are used to access the various functions initially available to the user. However, the expression of the two screens are not substantially similar, as a matter of law. In addition, many of the expressions which plaintiff argues are substantially simi-

lar are either not protected under the copyright or were licensed to Mr. Friend.

Good cause appearing therefor, the Court HEREBY GRANTS the motion for summary judgment.

V. SUMMARY

Plaintiff has presented the Court with a computer software program designed to facilitate the creation and editing of outlines. The allegedly infringing work encompasses the same idea and performs the same general functions as plaintiff's PC-Outline. Plaintiff has provided the Court with a list of similarities between the two programs which allegedly render the look and feel of defendant's Grandview program substantially similar to PC- Outline. Inasmuch as plaintiff refers to the use of similar functions, the use of a main editing screen, a menu bar, pull-down windows and the color scheme of the programs, these features are unprotectable under the copyright laws or are licensed to John L. Friend pursuant to the written contract. Plaintiff may not rely on these features in proving its case at trial.

Plaintiff also claims that the look and feel of the opening screens are substantially similar in the two programs. After redacting that material which is not protected under the copyright, or which has been licensed to Mr. Friend, the Court performed the required extrinsic and intrinsic tests mandated by law. The Court finds that although the opening screens share similar ideas, the screens are, as a matter of law, not substantially similar. Plaintiff has failed to meet its evi-

dentiary proof on this matter. No reasonable jury could find that the screens are substantially similar.

Good cause appearing therefor, the Court GRANTS the motion for summary judgment.

IT IS SO ORDERED.

ORDER DISMISSING

STATE LAW CLAIMS

On August 23, 1989, the Court granted defendants' motion for summary judgment on the federal copyright claims. The only remaining claims are state law claims which depend on the federal copyright claim. The Court will not exercise its pendent jurisdiction over those state claims. Good cause appearing therefor, the Court HEREBY DISMISSES the pendent state law claims, without prejudice.

IT IS SO ORDERED.

JUDGMENT

Pursuant to its Order Granting Summary Judgment and its Order Dismissing State Law Claims, Judgment is HEREBY ENTERED for defendants.

IT IS SO ORDERED.

APPENDIX C

Magistrate's "Order on Symantec's Motion for a Protective Order" (March 8, 1989)

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA SAN JOSE DIVISION

TELEMARKETING RESOURCES, a California corporation dba Brown Bag Software,

Plaintiff,

v

SYMANTEC CORPORATION, a California corporation, JOHN L. FRIEND, an individual and dba Softworks Development

Defendant.

And Related Counterclaim

NO. C 88-20352 RPA

ORDER ON SYMANTEC'S MOTION FOR A PROTECTIVE ORDER

Symantec's motion for a protective order came on for hearing on March 7, 1989. Defendant Friend joined in the motion.

Mitchell Zimmerman appeared for Symantec, Paul Warner appeared for John Friend and Brian Flynn appeared for plaintiff.

Good cause appearing therefor, IT IS HEREBY ORDERED that the motion for protection is GRANTED.

The stipulated protective order entered into by the clients and lawyers in this case anticipated that independent outside counsel have restricted access to confidential material designated "attorneys' eyes only" or "computer source code." At the time of the stipulated order all litigation counsel were outside counsel.

The plaintiff has sought the removal of its outside counsel and has designated its new and sole in-house counsel as counsel of record in this case. Plaintiff's in-house counsel is the first and only in-house counsel for Brown Bag Software. His responsibilities run the gamut of legal issues from personnel to intellectual property. Although clearly not a management employee, in-house

counsel's role is to advise management on all legal issues. He is also the corporation's Human Resource (personnel) person.

The stipulated protective order in this case clearly intended to prevent highly confidential information from being available to the parties. Under the circumstances of this case in-house counsel is so close to the party that the dangers of inadvertent disclosure of information is impossible to control.

The Court notes the good faith and integrity of in-house counsel in this case, however, he is in an untenable position as both litigation and in-house counsel.

The plaintiff is not precluded from prosecuting its case with counsel of its choice, however, it must seek the services of an independent consultant, legal or otherwise, to review and

advise on issues involving the "attorneys' eyes only" documents or the source code documents.

DATED:

/s/Patricia V. Trumbull
PATRICIA V. TRUMBULL
United States Magistrate

APPENDIX D

Judge's "Order Denying Motion for Extension of Discovery Cut-off Date and Denying Motion for Reconsideration of Magistrate's Ruling" (April 24, 1989)

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

TELEMARKETING RESOURCES,

Plaintiff,

vs.

SYMANTEC CORPORATION, a California corporation, JOHN L. FRIEND, an individual and dba Softworks Development

Defendant.

NO. C 88-20352 RPA

ORDER DENYING MOTION FOR EXTENSION OF DISCOVERY CUT-OFF DATE AND DENYING MOTION FOR RECONSIDERATION OF MAGISTRATE'S RULING

The Court has received, read and considered plaintiff's motions for 1) an extension of the discovery cut-off date and 2) reconsideration of the Magistrate's ruling. Good cause appearing therefor, the motions are DENIED.

On February 17, 1989, the Court denied defendant's motion to dismiss for lack of prosecution. At that time, the court in-

dicated the existing discovery cut-off date would be maintained and set forth a date for a summary judgment motion hearing. Defendant has failed to show due diligence or good cause why the discovery date should now be extended. Good cause appearing therefor, the motion to extend the discovery cut-off date is HEREBY DENIED. Nevertheless, plaintiff may complete all discovery commenced prior to the cut-off date.

Plaintiff's motion for reconsideration of the Magistrate's Order is HEREBY DENIED.

IT IS SO ORDERED.

DATED: April 24, 1989

/s/ Robert P. Aguilar
ROBERT P. AGUILAR
United States District Judge

APPENDIX E

U.S. Constitution

Art. 1, Sec. 8, Cl. 8. Patents and Copyrights.

To promote the progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

APPENDIX F

U.S. Constitution

AMENDMENT 5

No Person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offense to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

APPENDIX G

U.S. Constitution

AMENDMENT 6

In all criminal prosecutions, the accused shall enjoy the right to a speedy and public trial, by an impartial jury of the State and district wherein the crime shall have been committed, which district shall have previously ascertained by law, and to be informed of the nature and cause of the accusation; to be confronted with the witnesses against him; to have compulsory process for obtaining witness in his favor, and to have the Assistance of Counsel for his defense.

APPENDIX H

United States Code, Title 17

§ 101. Definitions

As used in this title, the following terms and their forms mean the following:

An "anonymous work" is a work on the copies or phonorecords of which no natural person is identified as author.

An "architectural work" is the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.

"Audio-visual works" are works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.

The "Berne Convention" is the convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, on September 9, 1886, and all acts, protocols, and revisions thereto.

A work is a "Berne Convention work" if--

(1) in the case of an unpublished work, one or more of the authors is a national of a nation adhering to the Berne Convention, or in the case of a published work, one or more of the authors is a national of a nation adhering to the Berne Convention on the date of first publication;

(2) the work was first published in a nation adhering to the Berne Convention, or was simultaneously first published in a nation adhering to the Berne Convention and in a foreign nation that does not adhere to the Berne Convention;

(3) in the case of an audio-visual work--

(A) if one or more of the authors is a legal entity, that author has its headquarters in a nation adhering to the Berne Convention; or

(B) if one or more of the authors is an individual, that author is domiciled, or has his or her habitual residence in, a nation adhering to the Berne Convention;

(4) in the case of a pictorial, graphic, or sculptural work that is incorporated in a building or other structure, the building or structure is located in a nation adhering to the Berne Convention; or

(5) in the case of an architectural work embodied in a building, such building is erected in a country adhering to the Berne Convention.

For purposes of paragraph (1), an author who is domiciled in or has his or her habitual residence in, a nation adhering to the Berne Convention is considered to be a national of that nation. For purposes of paragraph (2), a work is considered to have been simultaneously published in two

or more nations if its dates of publication are within 30 days of one another.

The "best edition" of a work is the edition, published in the United States at any time before the date of deposit, that the Library of Congress determines to be most suitable for its purposes.

A person's "children" are that person's immediate offspring, whether legitimate or not, and any children legally adopted by that person.

A "collective work" is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

A "compilation" is a work formed by the collection and assembling of pre-existing materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

A "computer program" is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.

"Copies" are material objects, other than phonorecords, in which a work is fixed by any method now know or later developed, and from which the work can be perceived repro-

duced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.

"Copyright owner," with respect to any of the exclusive rights comprised in a copyright, refers to the owner of that particular right.

The "country of origin" of a Berne Convention work, for purposes of section 411, is the United States if --

(1) in the case of a published work, the work is first published--

(A) in the United States;

(B) simultaneously in the United States and another nation or nations adhering to the Berne Convention, whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States;

(C) simultaneously in the United States and a foreign nation that does not adhere to the Berne Convention; or

(D) in a foreign nation that does not adhere to the Berne Convention, and all of the authors of the work are nationals, domiciliaries, or habitual residents of, or in the case of an audiovisual work legal entities with headquarters in, the United States;

(2) in the case of an unpublished work, all the authors of the work are nationals, domiciliaries, or habitual residents of the United States, or, in the case of an unpublished audiovisual work, all the authors are legal entities with headquarters in the United States; or

(3) In the case of a pictorial, graphic, or sculptural work incorporated in a building or structure, the building or structure is located in the United States.

For the purpose of section 411, the "country of origin" of any other Berne Convention work is not the United States.

A work is "created" when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.

A "derivative work" is a work upon one or more pre-existing works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modification which, as a whole, represent an original work of authorship, is a "derivative work."

A "device," "machine," or "process" is one now known or later developed.

To "display" a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in the case of a motion picture or other audiovisual work, to show individual images non-sequentially.

A work is "fixed" in a tangible medium of expression when its embodiment in a copy of phonorecord, by or under

the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is "fixed" for purposes of this title if a fixation of the work is being made simultaneously with its transmission.

The terms "including" and such as" are illustrative and not limitative.

A "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

"Literary works" are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

"Motion pictures" are audio-visual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.

To "perform" a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audio-visual work, to show its images in any sequence or to make the sounds accompanying it audible.

"Phonorecords" are material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "phonorecords" includes the material object in which the sounds are first fixed.

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of the utilitarian aspects of the article.

A "pseudonymous work" is a work on the copies or phonorecords of which the author is identified under a fictitious name.

"Publication" is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership or rental, lease, or lending. The offering to distrib-

ute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication. A public performance or display of a work does not of itself constitute publication.

To perform or display a work "publicly" means-

(1) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or

(2) to transmit or otherwise communicate a performance or display of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive in the same place or in separate places and at the same time or at different times.

"Sound recordings" are works that result from the fixation of series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disk, tapes, or other phonorecords, in which they are embodied.

"State" includes the District of Columbia and the Common- wealth of Puerto Rico, and any territories to which this title is made applicable by an Act of Congress.

A "transfer of copyright ownership" is an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of copyright or any of the exclusive rights comprised in a copyright, whether or not it is limited

in time or place of effect, but not including a non-exclusive license.

A "transmission program" is a body of material that, as an aggregate, has been produced for the sole purpose of transmission to the public in sequence and as a unit.

To "transmit" a performance.or display is to communicate it by any device or process whereby images or sounds are received beyond the place from which the are sent.

The "United States," when used in a geographical sense, comprises the several States, the District of Columbia and the Commonwealth of Puerto Rico, and the organized territories under the jurisdiction of the United States Government.

A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article."

The author's "widow" or "widower" is the author's surviving spouse under the law of the author's domicile at the time of his or her death, whether or not the spouse has later remarried.

A "work of visual art" is--

(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated

sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include--

(A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;

(ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;

(iii) any portion or part of any item described in clause (i) or (ii);

(B) any work made for hire; or

(C) any work not subject to copyright protection under this title.

A "work of the United States Government" is a work prepared by an officer or employee of the United States Government as part of that person's official duties.

A "work made for hire" is-

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them

that the work shall be considered a work made for hire. For the purpose of the following sentence, a "supplementary work" is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwards, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

APPENDIX I

United States Code, Title 17

§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) Literary works;
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphics, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

APPENDIX J

United States Code, Title 17

§ 103. Subject matter of Copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes complications and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

Supreme Court, U.S.
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No. 92-178

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1992

BB ASSET MANAGEMENT, INC., Transferee
Through BROWN BAG SOFTWARE, INC.
Petitioner

vs.

SYMANTEC CORPORATION and JOHN L. FRIEND,
an individual and dba SOFTWORKS DEVELOPMENT
Respondents

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

Opposition Brief of Respondent Symantec Corporation

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QUESTIONS PRESENTED

1. Did the Magistrate abuse her discretion by declining to permit plaintiff's in-house counsel to have immediate and unfettered access to a competitor's confidential documents where:

(a) plaintiff's outside attorneys had already had the confidential documents in their possession for six months,

(b) plaintiff offered no showing that the documents were relevant to any issues in the case,

(c) the Magistrate did NOT limit access to the documents "solely" because the plaintiff's attorney was its in-house counsel, but expressly considered all the facts and circumstances, and

(d) the Magistrate established a procedure whereby in-house counsel could seek access to particular confidential documents based on need, and plaintiff chose never to invoke the procedure?

2. Can plaintiff Brown Bag's central contention on the copyright issue — that the district court erred in (supposedly) failing to compare the two computer programs in their entireties — be addressed on the record here, when (1) Brown Bag itself asked the district court to perform the very element-by-element analysis which Brown Bag now contends was error and (2) Brown Bag never introduced, as part of its opposition to summary judgment, the entire programs which it now says the court should have considered?

3. Did the district court properly grant summary judgment against the claim that defendant Symantec's computer program copied the user interface of plaintiff's program where:

(a) the expressive aspects of the Symantec computer screen displays, viewed by the district court both individually and as a totality, were manifestly different from the Brown Bag screens, and

(b) all of the purported similarities listed by plaintiff itself were features that defendants were specifically licensed to use, were unprotectable under copyright, or represented demonstrably *different* expression?

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RULE INVOLVED IN THIS CASE

Rule 26(c) of Federal Rules of Civil Procedure:

> "*Protective Orders.* Upon motion by a party or by the person from whom discovery is sought, and for good cause shown, the court in which the action is pending or alternatively, on matters relating to a deposition, the court in the district where the deposition is to be taken may make any order which justice requires to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following: (1) that the discovery not be had; (2) that the discovery may be had only on specified terms and conditions, including a designation of the time or place; (3) that the discovery may be had only by a method of discovery other than that selected by the party seeking discovery; (4) that certain matters not be inquired into, or that the scope of the discovery be limited to certain matters; (5) that discovery be conducted with no one present except persons designated by the court; (6) that a deposition after being sealed be opened only by order of the court; (7) that a trade secret or other confidential research, development, or commercial information not be disclosed or be disclosed only in a designated way; (8) that the parties simultaneously file specified documents or information enclosed in sealed envelopes to be opened as directed by the court.
>
> "If the motion for a protective order is denied in whole or in part, the court may, on such terms and conditions as are just, order that any party or person provide or permit discovery. The provisions of Rule 37(a)(4) apply to the award of expenses incurred in relation to the motion."

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Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

Opposition Brief of Respondent Symantec Corporation

INTRODUCTION

This case involves routine issues of no compelling importance beyond the immediate parties, and there is no reason for this Court to grant certiorari. Petitioner's first issue concerns a discovery dispute subject only to review for abuse of discretion, which the Ninth Circuit has already considered. Petitioner's second issue concerns the routine application of summary judgment standards to the evidence in a copyright dispute. The result is ruled by an assessment of the facts, and after careful consideration the Ninth Circuit confirmed the obvious result. No novel issue of law is presented. There is no reason for this Court to devote its scarce resources to yet another review of either the Magistrate's exercise of discretion or the factual basis for summary judgment.

STATEMENT OF THE CASE

A detailed Statement of the Case is required because petitioner Brown Bag has mischaracterized and distorted the record, notably by (1) falsely asserting that the Magistrate denied Brown Bag access to Symantec's confidential documents "solely" because Brown Bag's attorney was an in-house counsel and (2) misleadingly suggesting that the district court was at fault for (supposedly) failing to compare the entireties of the copyrighted computer program and the allegedly infringing work, when in fact Brown Bag never offered the entire programs into evidence. A careful review of the facts is also required because it discloses that even if Brown Bag's legal contentions had any merit, they could have no impact on the outcome since the undisputed facts show that the two programs are demonstrably different.[1]

I. Brown Bag's Complaint and Motion for Preliminary Injunction.

On June 8, 1988, Brown Bag Software filed a complaint for copyright infringement and related claims, accompanied by a motion for preliminary injunction, against Symantec and software developer John Friend. The complaint alleged that Symantec's and Friend's computer program GrandView infringed the copyright of Brown Bag's program PC-Outline, and the motion sought to bar Symantec from marketing GrandView.

Although Brown Bag's moving papers asserted that the "primary basis" for the motion was the supposed "substantial similarity in . . . audiovisual displays [the computer screens] between

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[1]Record references are as follows: "Docket No. _____" refer to the district court's docket sheet. "App. _____" refers to the appendices to Brown Bag's petition for certiorari. The Court of Appeals' opinion in this case is referred to as "9th Cir.Opn. [App. A]," the district court opinion granting summary judgment is referred to as "D.Ct.Opn. [App. B]," and the Magistrate's discovery ruling is referred to as "Mag.Ord. [App. C]."

"Resp. App." refers to Respondent's Appendix, one copy of which has been lodged with the Clerk. Respondent's Appendix consists of the transcript of the hearing on the discovery order challenged in Argument I of the petition; the transcript includes the Magistrate's oral ruling which supplements and clarifies the written Order on Symantec's Motion for a Protective Order entered March 8, 1989.

PC-Outline and GrandView" (Docket No. 4, p. 7), Brown Bag submitted neither the programs themselves nor any depictions of the computer screens. Defendants, however, provided a set of screen display pictures and other evidence. After comparing that evidence with Brown Bag's claims, the district court denied the motion. (Docket No. 33.)[2]

II. Subsequent Procedural Developments and the Discovery Dispute At Issue Here.

A. Magistrate Issues Seven Discovery Orders Against Brown Bag.

Following the denial of its preliminary injunction motion, Brown Bag persistently obstructed discovery, requiring the Magistrate to enter seven (7) discovery orders against Brown Bag. An order was even required that Brown Bag's president Sanford B. Schupper cease taking cellular telephone calls while being questioned during his deposition. (Docket Nos. 39, 41, 45, 47, 76, 113, 139.)

B. Withdrawal of Limbach firm and Appearance of In-House Counsel Brian J. Flynn.

On February 17, 1989 the district court granted the motion of Brown Bag's outside counsel to withdraw. On that same date, Brown Bag's newly hired in-house counsel Brian J. Flynn entered his appearance on behalf of Brown Bag. (Docket Nos. 89, 100.)

C. Dispute Over In-House Counsel's Access to Defendants' Confidential Source Code and Trade Secrets.

1. The Documents Sought by In-House Counsel.

At the outset of the litigation, defendants produced various confidential documents to Brown Bag's outside counsel under a Protective Order that barred Brown Bag or its employees from seeing the documents. (Docket No. 36; Resp. App. [Trans. of

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[2]Brown Bag admitted that it timed the filing of the suit on the eve of Symantec's anticipated initial public offering of shares in order to give Brown Bag a tactical advantage. Brown Bag's president Sanford B. Schupper told an uninvolved third party, the president of Paperback Software International, that Brown Bag was going to delay filing suit until Symantec's initial public offering was imminent because Brown Bag considered it "more advantageous to wait until 'closer to the offering.' " (Cook Decl. ¶¶ 3-5 [Docket No. 13].)

proceedings before Magistrate] pp. 7-9.) Immediately following Mr. Flynn's appearance in the case, he demanded that former outside counsel turn those confidential documents over to him.

The confidential documents included the computer source code to Symantec's computer program GrandView, as well as documents that revealed important future development plans for GrandView, product development practices, the identity of Symantec's valued "beta testers" and other trade secrets. As the Ninth Circuit pointed out below, the extreme sensitivity of these trade secrets and the potential damage to Symantec should they inadvertently be divulged to Brown Bag were undisputed. (9th Cir.Opn. [App. A] p. 3727.)

2. Defendant's Motion for Protective Order and the Magistrate's Findings of Fact.

Symantec and co-defendant Friend (the original developer of GrandView) promptly objected to Brown Bag obtaining access to their confidential documents, and moved for a protective order against disclosure to Brown Bag's in-house counsel Mr. Flynn. Contrary to petitioner's assertion that the Magistrate granted the protective order "solely" because Mr. Flynn was an in-house counsel (see, e.g., Certiorari Petition at pp. i, 5-6, 8, 13), the Magistrate had a full factual record before her and carefully considered all of the facts and circumstances before deciding the issue. Indeed, the parties submitted five declarations setting forth relevant facts and the Magistrate held a long and comprehensive evidentiary hearing on the motion. (Docket Nos. 91-97, 99; Resp. App. 1-52.)

(i) *Facts obtained by the Magistrate relevant to the risks of misuse of Symantec's trade secrets.* At the evidentiary hearing, the Magistrate closely questioned Brown Bag's in-house counsel in order "to look at, basically, what in-house counsel does." (Resp. App. 5, 27) The Magistrate found as a matter of fact, based on Mr. Flynn's own statements (Resp. App. 29-30), that Mr. Flynn "is the first and only in-house counsel for Brown Bag Software," that "[h]is responsibilities run the gamut of legal issues from personnel to intellectual property," that his "role is to advise management on all legal issues," and that he "is also the corporation's Human Resource (personnel) person." (Mag.Ord. [App. C].) Mr. Flynn himself described Brown Bag as a "very small company" with only "approximately 13 or 14 employees."

(Resp. App. 20.) He described his legal responsibilities as "quite broad," and acknowledged that they included "about any legal kind of problem that conceivably could come up in a small corporation." (Resp. App. 29.)

Mr. Flynn was unable to give any assurances regarding the limits of his responsibilities and activities because, having been so recently hired (Resp. App. 30), he did not yet know much about his own job. Indeed, even though he was also the personnel director, he could not give the Magistrate a breakdown of the functions of the different employees of Brown Bag because he was "not sure who the 13 or 14 people are or what they do." (Resp. App. 21.)

The Magistrate made a specific factual finding, based on the entire record, that Mr. Flynn "is so close to [Brown Bag] that the danger of inadvertant disclosure of information is impossible to control." (Mag.Ord. [App. C].) That factual finding was not challenged as clearly erroneous.

(ii) *The showing considered by the Magistrate concerning the relevance of the confidential documents.* At the hearing before the Magistrate, Symantec repeatedly pointed out that the confidential documents were irrelevant to the real issues in the case, and Brown Bag failed to offer any showing of relevance. (Resp. App. 14-17; 19-30.) The only theory of copyright infringement ever presented by Brown Bag was that Symantec's Grandview program copied the "look and feel" or "user interface" of Brown Bag's PC-Outline program; that is, that Symantec's program copied the computer screen displays and other features which the user perceives in working with the program.

Since the "user interface" of a program is not secret, a so-called "look and feel" claim can be assessed by "looking and feeling" — not by studying confidential documents and trade secrets. As the Ninth Circuit correctly held, "none of the trade secrets were themselves relevant to Brown Bag's 'look and feel' infringement claim, a claim dependent on comparison of the two published programs." (9th Cir.Opn. [App. A] p. 3729.)

Brown Bag now asserts, in this forum for the first time, that some of the documents could have been relevant to a claim that Symantec copied the computer source code underlying Brown Bag's program (Petition at p. 6). But Brown Bag never told the Magistrate that the documents might be relevant for that reason

nor did Brown Bag make any such argument to the Ninth Circuit. Indeed, Brown Bag's Rule 30(b)(6) witness acknowledged that Brown Bag was not alleging source code copying, a fact that was brought to the district court's attention during the summary judgment proceedings. (Docket No. 131, Exh. A.)

3. The Magistrate's Balanced Ruling.

Based on her factual findings and on the showing as to the documents' relevance, the Magistrate resolved the matter as follows: (1) The Magistrate decided that Mr. Flynn should not have immediate, unfettered access to the documents at issue. (Mag.Ord. [App. C].) (2) Instead, the Magistrate authorized Brown Bag's "independent consultant, legal or otherwise, to review and advise on issues involving the 'attorneys' eyes only' documents or the source code documents" and to report to Mr. Flynn concerning the results of that review. (Mag.Ord. [App. C].) (3) Finally and most importantly, the Magistrate established a procedure whereby Mr. Flynn could seek direct access to any relevant documents: If, following the review of the documents by Brown Bag's independent consultant, it is "the opinion of the outside consultant that in house counsel needs that material in order to pursue the litigation," Brown Bag could bring "a very specific request, item by item to the court, for the items that [Brown Bag] deem[s] to be necessary." (Resp. App. 48-49.)

Although Brown Bag did use an independent consultant to oppose summary judgment, Brown Bag never attempted to invoke the procedure established by the Magistrate. (9th Cir.Opn. [App. A] p. 3730.)

III. Defendants' Motion for Summary Judgment.

A. The Parties' Summary Judgment Submissions.

Following the close of discovery, Symantec and John Friend moved for summary judgment. The motion was supported by numerous declarations and exhibits, by Brown Bag's Rule 36 Admissions, and by admissions from the deposition of Brown Bag's Rule 30(b)(6) witness Sanford B. Schupper.

In opposition to summary judgment, Brown Bag submitted only the declarations of its expert Ronald Ogg and of Brown Bag president Stanford B. Schupper. (Docket No. 137.) Ogg's declaration included no exhibits and merely offered a list of purported similarities between GrandView and PC-Outline (*id.*,

¶ 5(a)-(q)) plus Ogg's opinion that the two programs were substantially similar. (*Id.*, ¶ 6). Schupper's declaration stated no independent facts, but attached as exhibits five pairs of photographs of the main working screens of the two programs, a section of the user manual for Symantec's program, and two newspaper articles on Symantec's GrandView.

Neither declaration included the entire programs at issue nor did Brown Bag submit a comprehensive set of photographs of all of the screen displays of the two programs. Thus, the only *facts* that Brown Bag proffered as a basis for denying the motion were those listed by Mr. Ogg, as illustrated in part by the handful of photos attached to Schupper's declaration.

B. Defendants' Motion to Strike the Declaration of Brown Bag's Expert.

Symantec and Friend moved to strike the Ogg declaration on the grounds that it was comprised of expert testimony inadmissible on the issue of substantial similarity, *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977), and that Brown Bag had concealed and failed to disclose Ogg's identity in response to interrogatories.

The district court stated that Ogg's declaration "contains expert opinion as to the similarity of the two programs, [and] will not be considered." Notwithstanding, the district court expressly ruled that it would apply the list of alleged similarities contained in Ogg's declaration in assessing Brown Bag's claims. (D.Ct.Opn. [App. B] p. 8 fn.3.) As a result, nothing that Ogg had to say (other than his conclusory assertion that the two programs were similar) was in fact excluded from the district court's consideration. Rather, the district court did precisely what Brown Bag asked — it considered whether the two programs were similar with respect to each of the discrete items specified in Ogg's list of purported similarities.

C. Scope of the District Court's Consideration of the Evidence.

As the Ninth Circuit pointed out, "there was no reason we should expect the district court to have made the analysis Brown Bag now requests" insofar as "no such evidence [of the entire program] was ever included as part of Brown Bag's opposition to Symantec's summary judgment motion" and since "the record

fails to include any evidence indicating that Brown Bag requested the district court to make this analysis." (9th Cir.Opn. [App. A] p. 3739.)

Nonetheless, in its effort to fairly consider Brown Bag's list of supposed similarities in context, the district court *sua sponte* directed the parties to provide in-court demonstrations of the two programs, and the court also examined the actual programs in chambers. (D.Ct.Opn. [App. B] p. 1.) Because of the two in-court demonstrations and the court's examination of the two programs, the district court was able to and in fact did go beyond Brown Bag's paper showing and consider the entirety of the two programs.

IV. The Facts That Were Before the District Court When It Ruled on Brown Bag's Copyright Claim.

A. Symantec's "Invention" of Computer Outlining.

This case involves several computer programs that perform outlining functions and that embody various expressions of the ideas inherent in computer outlining. It was the defendant Symantec which in 1983 first developed a practical and successful computer outlining program, the "seminal" outliner known as ThinkTank. (Docket No. 122.) Thereafter, Symantec "developed and marketed two more outlining programs, 'Ready' and 'MORE' . . . ." (9th Cir.Opn. [App. A] pp. 3722-23.)

B. The Development of PC-Outline and GrandView.

Defendant John L. Friend, an independent computer program designer, subsequently developed a new outlining program called "PC-Outline," which Friend acknowledged was "inspired by" Symantec's ThinkTank program; indeed, "Friend stated that he 'borrowed' several of ThinkTank's features for PC-Outline." (9th Cir.Opn. [App. A] p. 3723.) In 1987, Friend sold PC-Outline to Brown Bag's predecessor in interest as the result of a series of manipulations by the company's principal Sanford B. Schupper.[3]

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[3]The following facts were undisputed in the summary judgment proceedings: Schupper, as president of Brown Bag's predecessor Software Resources Group, Inc., concealed the fact that Software Resources was already in Chapter 11 bankruptcy proceedings, and induced Friend to grant Software Resources an exclusive license in exchange for a promise of minimum royalty payments of $250,000.

The agreement by which Brown Bag's predecessor obtained PC-Outline expressly contemplated that Friend would be free to develop other programs and the agreement explicitly licensed Friend to use some 129 pages of the PC-Outline computer source code in future computer programs that he might write. As discussed below, the source code which Friend was entitled to use includes "routines" that create virtually all of the screen display similarities which supposedly show that Symantec and Friend copied the user interface of PC-Outline.

Also in 1987, Friend developed the outlining program which came to be known as "GrandView," and sold the marketing rights to that program to Symantec. (Docket Nos. 130, 121.) Immediately after their agreement was signed, Symantec and Friend began a protracted process of consultations over modifying the user interface of GrandView, specifically to ensure that GrandView's user interface would be similar to that of Symantec's existing programs MORE and ThinkTank.[4]

Friend never received the promised payments. (Docket No. 130 ¶¶ 7-12.)

Subsequently Friend abandoned PC-Outline to Schupper in exchange for a nominal payment and the rights described below. By this time, Schupper had purchased some of the assets of his bankrupt Software Resources Group entity, including its rights to PC-Outline, which he transferred to a new corporation which came to be known as Brown Bag Software, Inc. In the fullness of time, Mr. Schupper also placed the new Brown Bag Software into bankruptcy (*id.*, ¶ 11). Interestingly, petitioner reports that an unnamed "secured creditor" has purchased PC-Outline from the second bankrupt Brown Bag entity, and transferred it to a new entity known as BB Asset Management, the petitioner herein.

[4]The systematic efforts to make the user interface of GrandView more "MORE-like" and "ThinkTank-like" were fully documented in contemporaneous communications between Friend and Symantec which state in part:

> ". . . These [changes in features] aren't great, but [will be] familiar to ThinkTank users."
>
> ". . . Suggest that these commands move to Reorganize menu to compare well to MORE/ThinkTank . . ."
>
> "I changed it to be like MORE." (Docket No. 121, Exhs. E and F.)

In part as a result of this developmental process, it was demonstrably the case, as the district court saw when it compared the programs, that the user interface of Symantec's GrandView program was similar to and based on Symantec's own program MORE, and was decidedly not similar to Brown Bag's PC-Outline program.

C. A Comparison of the User Interface of GrandView and PC-Outline.

The district court had before it the list of Mr. Ogg, Brown Bag's expert, representing supposed similarities between GrandView and PC-Outline, and the evidence that defendants placed before the Court. How did the programs compare? The district court engaged in a careful analysis and concluded that each of the features on Brown Bag's list represented either (1) an expressive feature that was in fact different between the two programs, (2) a feature that Friend was entitled to use under his license with Brown Bag, and/or (3) a feature unprotectable under copyright law. Brown Bag has not disputed any of these conclusions.

Now Brown Bag contends that the district court missed the forest for the trees. Brown Bag argues that even though many elements of the PC-Outline user interface were not copyrightable, the entirety could still add up to a unique copyrightable combination of elements, and the district court erred in not comparing the two works as a whole.

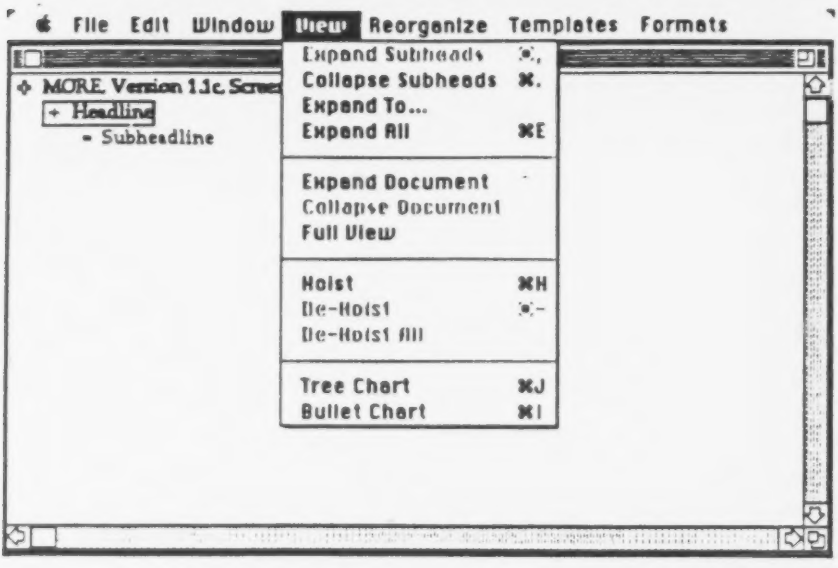
Leaving aside any legal issues, in so arguing Brown Bag ignores the critical and undisputed facts that were before the district court which showed that the two programs were *different* as to all of the categories of user interface features that Brown Bag itself pointed to. In light of Symantec's uncontested showing that the programs were comprehensively different in their user interface features, the argument that it was error not to have compared the entire works is frivolous. When the identified key elements of one program are overwhelmingly and systematically found to be different from the corresponding elements of another program, the entire works cannot be found to be similar.

1. The Menu Structures of the Two Programs Are Different.

The user of any outlining program can use the program to perform a variety of tasks, including reorganizing parts of the outline, editing, copying, printing, and saving. These functions can

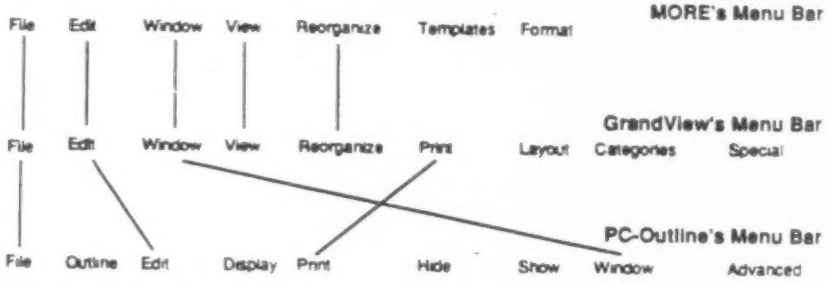
be invoked in a variety of means. (Docket Nos. 121, 122.) For example, special keys on the computer keyboard, known as "function keys," provide certain options. Functions can also be selected as choices from "menus" — lists of available commands and options. (*Id.*)

One common means of presenting the menus is to display a horizontal list of titles on a "Menu Bar" at the top line of the computer screen; the complete menu for each menu title can then be "pulled down" by using certain keys or a pointing device known as a "mouse." Below we depict one of the computer screen displays that could be seen in the course of using Symantec's earlier outlining program MORE. This "screen shot" shows the "Menu Bar" at the top ("File" through "Formats") and shows the "View" Menu pulled down. (Docket No. 121, Exh. A.)



Brown Bag's declarant Ogg asserted that there were similarities in the menus and menu bars of GrandView and PC-Outline, as well as in the titles and functions of the menus. (Docket No. 137.) But the actual menu screen depictions offered by defendants conclusively proved that the menus were different in structure, order and terminology, a point conceded by Brown Bag in its Rule 36 Admissions.

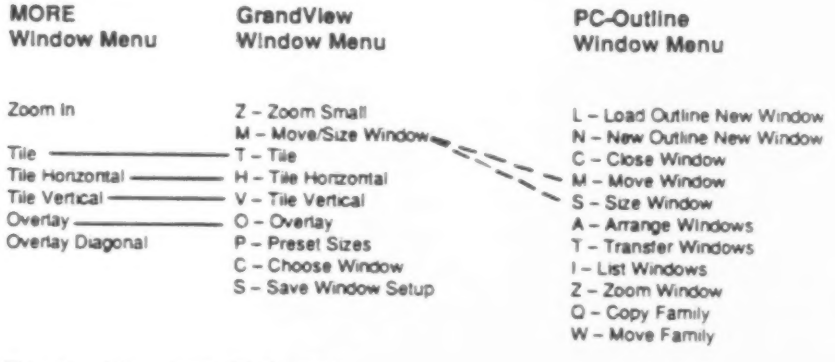
To illustrate, arranged below are the Menu Bars of Symantec's MORE, Symantec's GrandView and Brown Bag's PC-Outline, with lines drawn between the menu names that are the same:



(Docket No. 121, Exh. J.)

The name and order of the first five menus in MORE and GrandView are identical. Both the menu names and the order in which they appear are substantially different in GrandView and PC-Outline. (Docket No. 121, ¶¶ 33-34.) Moreover, all of the names common to PC-Outline and GrandView are standard industry terms in general use in many Macintosh and other programs. (Docket No. 130, ¶ 26(d); Docket No. 122.)

The individual Grandview and PC-Outline menus are even more obviously different. Note, for example, the menu choices of the "Window" menus for MORE, GrandView and PC-Outline shown below. (To facilitate a closer comparison, solid lines connect identical menu names; dashed lines connect arguably similar names.)



(Docket No. 121, Exh. K.)

Although the menus for the two Symantec programs MORE and GrandView are not identical, the geneology is obvious. Most

of the menu names in GrandView are copied from MORE, and the order of the menu functions has been maintained between the two. It is equally apparent that the Window menu in Brown Bag's program uses entirely different names. The remaining menus that were placed before the district court reflected even more strongly that the GrandView menu structure and terminology owe nothing to PC-Outline. (Docket No. 121, Exhs. G-K.)[5]

The lack of substantial similarity between GrandView's and PC-Outline's menus was admitted by Brown Bag in response to Symantec's Rule 36 Requests for Admissions. Plaintiff admitted that none of the command choices contained in six of Grandview's nine main menus were substantially similar to any of the command choices in the corresponding PC-Outline menus (Admissions 10, 23, 48, 53, 63 & 79 [Docket No. 126].) Plaintiff also admitted that most of the command choices in the remaining menus were not substantially similar. (Admissions 15-17, 31, 39.)[6]

2. The Opening Screens Are Similar Only in Ideas or Merged Expression and the Screens Look Completely Different.

More than a third of the paragraphs of Mr. Ogg's declaration, listing purported similarities between GrandView and PC-Outline, concern the initial computer screens that include the opening menus. (Docket No. 137, ¶ 5(a)-(g).) The district court correctly found that none of the listed features was protectable. The court found, for example, that such features as calling an opening menu "Opening Menu" represented a merger of idea and expression, and that the need to access existing files was an idea inherent in an outlining program.

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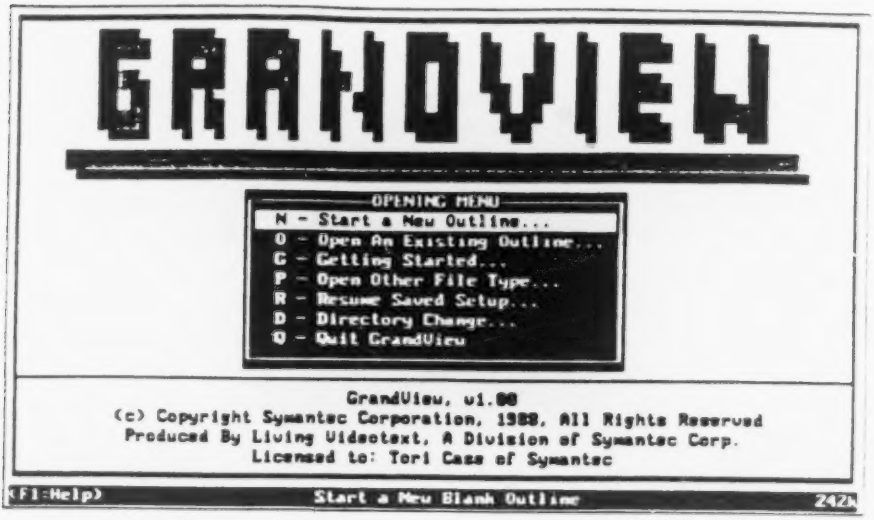
[5]This is not to concede that either the order of the terms contained in the menus or the menu terminology are protectable under copyright. *See* 17 U.S.C. ¶ 102(b). But the simple fact is that the GrandView and PC-Outline menus are decidedly different.

[6]Brown Bag served no response to Symantec's Requests for Admissions (attached as Exh. E to Docket No. 126), consequently all of the Requests were automatically deemed admitted pursuant to the express terms of Rule 36. *Accord, United States v. Kasuboski*, 834 F.2d 1345, 1349 (7th Cir. 1987); *O'Bryant v. Allstate Ins. Co.*, 107 F.R.D. 45 (D. Conn. 1985). (Docket No. 127, pp. 18-22, 24-26.)

Although Brown Bag now faults the district court for supposedly ignoring the big picture, Brown Bag conveniently omitted from its evidentiary showing any picture of those opening screens. But Symantec submitted "screen shots" of the two, shown below. (Docket No. 145, Exh. A.) No wonder Brown Bag chose not to provide the district court with the entire works. A glance confirms that in fact the opening screens viewed as a whole are utterly different.



3. The Color Scheme of the Programs Is Uncopyrightable, Functional, and Largely Different.

Mr. Ogg asserted, as another purported similarity, that the main editing screens of the two programs have similar color schemes. Although the district court correctly held color to be unprotectable and functional in character (D.Ct.Opn. [App. B] p. 12), it was as a matter of fact undisputed that most of the colors used in the two programs are different. Of the 44 "default" color selections made by the GrandView program, fewer than 10 (less than one quarter) are the same as the color selections in PC-Outline. (Docket No. 130.)

4. The Special Keystroke Combinations and Procedures are Not Protectable and Are Different.

Mr. Ogg also made the conclusory assertion that the procedures or keystrokes used for performing various functions are similar between the two programs. (Docket No. 137, ¶ 5.) But a systematic examination of all of the keystroke short-cuts (used to perform functions without going through the menus) revealed that of 211 such keystrokes, there are only 25 (11 percent) which are common to the two programs, and 14 of those are standard in the industry. (Docket No. 130, ¶ 30 & Exh. D); Brown Bag Admission No. 76 (Docket No. 126). Similarly, the specific procedures for performing common outlining tasks are different. (Docket No. 130, ¶ 26(i)-(1).)[7]

5. The Main Editing Screens of the Two Programs Are Not Copyrightable and Any Similarities Were Licensed to Friend.

Although many of the paragraphs of Ogg's list of purported similarities between GrandView and PC-Outline concern the appearance of the main editing screens of the two programs (Docket No. 137, ¶ 5), Brown Bag basically admits in its certiorari petition that those computer screens are merely uncopyrightable blank forms: "[O]utlining programs, such as PC-Outline," Brown Bag itself states, "begin with essentially blank screens, and

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[7]It is undisputed in this action that keystroke patterns are not protectable under copyright in light of 17 U.S.C. § 102(b): "In no case does copyright protection . . . extend to any . . . procedure, process, [or] method of operation . . . ."

the users create . . . outlines in which the users input their own information." (Petition at p. 28.) Such forms, it is long established, are not copyrightable. *Baker v. Selden*, 101 U.S. 99, 107 (1880) ("blank account-books are not the subject of copyright").

Moreover, the main working screen of GrandView is nothing more than the sum of the screen features that Friend was entitled to use under his license with Brown Bag. The agreement that transferred PC-Outline to Brown Bag expressly licensed Friend to use 129 pages of computer source code, code that generates the very screen features that Brown Bag claims are infringed. (Docket No. 165.) Brown Bag never disputed below that Friend was specifically entitled to create new programs using source code that would (1) draw a menu bar at the top of the screen, (2) draw a menu bar with one of the options highlighted in reverse video, (3) display a pull down menu, (4) permit the user to select an item on the menu by using the first letter of the menu item, (5) highlight a currently selected menu option, (6) draw a single-line bordered box around menus and windows, and (7) draw a message line at the bottom of the screen. (*Id.*) A moment's perusal of the main editing screens (Docket No. 121, Exh. L; following page) confirms that these features comprise virtually the entire display and that the screens are indeed blank forms.

The only elements of the main working screens that were not created by using Friend's licensed code were the content of the menu bar and message line, which are *different* in the two programs, and certain details of the screen display which are also *different*. (Docket No. 121.)

* * *

In sum: Although Brown Bag asserts that the district court erred by (supposedly) not comparing the programs as a whole, as to all of the elements addressed by Brown Bag itself the two programs are overwhelmingly and undisputedly different.

GrandView, Version 1.0, 6/19/1988

PC Outline Version 3.38 6/19/88

REASONS FOR DENYING THE WRIT

I.

BROWN BAG'S CLAIM THAT IT HAS A CONSTITUTIONAL RIGHT TO HAVE ITS IN-HOUSE COUNSEL EXAMINE A COMPETITOR'S TRADE SECRETS IS FRIVOLOUS.

Petitioner Brown Bag contends that its constitutional right to choice of counsel was violated because the Magistrate purportedly denied Brown Bag's in-house counsel access to Symantec's confidential documents, supposedly based "solely" on the fact that Brown Bag's attorney was an in-house counsel.

Brown Bag's claim rests on two blatant falsehoods. First, the Magistrate did not bar Brown Bag from having access to confidential documents, but only required Brown Bag first to use a reasonable procedure set forth by the Magistrate. Second, the Magistrate's decision did not rest only on the fact that Mr. Flynn was in-house counsel. In bold contrast to Brown Bag's repeated, disingenuous assertion that the Magistrate's decision rested "solely" on Mr. Flynn's status as an in-house attorney (see, e.g., Petition at pp. i, 5-6, 8, 13), the record unequivocally shows that the Magistrate examined *all* of the facts and circumstances connected with Mr. Flynn's role at Brown Bag. The Magistrate only rejected Mr. Flynn's demand for unfettered and unconditional access to Symantec's secrets after expressly finding that "*under the circumstances of this case* in-house counsel is so close to the party that the danger of inadvertent disclosure of information is impossible to control." (Mag.Ord. [App. C] p. 2, emphasis added.)

Brown Bag offers no authority in support of its assertion that its constitutional rights were violated. Brown Bag's argument is frivolous because on the actual facts of this case it is impossible to argue that the Magistrate's decision represents reversible error under the relevant standard, abuse of discretion.

A. The Constitution Was Not Violated by the Magistrate's Exercise of Discretion.

It is apparently Brown Bag's position that the constitutional right to counsel is offended by any limitations on in-house counsel's "right" to review confidential documents provided by its competitors.

Nonsense. Nothing in the Constitution gives a litigant's employees the right to possess another party's trade secrets and proprietary information, and no case has ever held that it does. The fact that a plaintiff chooses to use its in-house lawyer as its sole counsel of record does not give it an absolute right to obtain its competitor's confidential documents. Rather, as Rule 26(c) of the Federal Rules of Civil Procedure anticipates, it is well within a court's legitimate power and discretion to "make any order which justice requires to protect a party [from] oppression . . . including [an order] that a trade secret or other confidential research, development, or commercial information not be disclosed or be disclosed only in a designated way . . ."

The reasonable procedures that the Magistrate imposed as a condition for Brown Bag's in-house counsel to obtain access to Symantec's confidential information were plainly not beyond the constitutional powers of the district court and did not violate Brown Bag's fundamental rights.

In reality, a district court's order limiting the disclosure of confidential documents implicates no constitutional issues, and, it is well-established, is simply reviewed for abuse of discretion.[8]

B. Brown Bag Waived The Issue By Not Invoking the Procedure to Gain Access to the Documents and Not Asserting the Issue in Opposing Summary Judgment.

Under the Magistrate's order, it was incumbent on Brown Bag to have an independent consultant review the confidential documents if Brown Bag's in-house counsel wanted to pursue the issue. Brown Bag did obtain the services of an (apparently) independent computer consultant and submitted his declaration in opposition to summary judgment. (Docket No. 137.) But Brown Bag failed to use its consultant to determine whether any

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[8] *F.T.C. v. Exxon Corp.*, 636 F.2d 1336, 1349 (D.C. Cir. 1980) (denial of access to confidential documents by in-house counsel affirmed on basis of abuse of discretion standard); *KL Group v. Case & Lynch*, 829 F.2d 909, 915 (9th Cir. 1987) ("We review the district court's grant of a protective order relating to discovery for abuse of discretion"); *Hartley Pen Co. v. U.S. District Court*, 287 F.2d 324, 330, 331 (9th Cir. 1961) (district court's decision to require disclosure of trade secret subject to abuse of discretion standard; held an abuse of discretion where insufficient showing of relevance and necessity).

confidential documents were relevant, failed to invoke the procedures specified by the Magistrate for re-visiting the issue, failed to assert lack of access to confidential documents as a ground for opposing summary judgment, and failed to file a Rule 56(f) affidavit asking for more time in which to investigate the documents. Brown Bag thereby waived the issue. *Adkins v. E. I. Du Pont De Nemours & Co.*, 181 F.2d 642 (10th Cir. 1950) (after discovery responses stayed, plaintiff who failed to raise issue of discovery stay again at time of summary judgment motion barred from raising issue on appeal).[9]

C. Brown Bag Misrepresents the Magistrate's Order.

Brown Bag's entire argument rests on the false premise that the Magistrate's protective order "denied Brown Bag's trial counsel access to the confidential material . . . solely because he was in-house counsel." (Petition at pp. 5-6.) But Magistrate Trumbull's decision in fact rested on the very multi-factor, case-by-case balancing test mandated by *U.S. Steel Corp. v. U. S.*, 730 F.2d 1465 (Fed.Cir. 1984), which Brown Bag relies on.[10] In affirming, the Ninth Circuit expressly adopted a similar balancing test, and observed that "[t]he record belies [Brown Bag's] contention" that the magistrate failed to perform the required factual inquiry

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[9]As the Ninth Circuit stressed in this case, "Brown Bag failed to demonstrate how the protective order actually could have or did prejudice its case. Brown Bag never attempted to implement the independent consultant method of access to the trade secrets and never argued the method was unduly burdensome. Instead, Brown Bag alleged its unfettered right to the discovery documents and complained of arbitrary discrimination against in-house counsel. Brown Bag's arguments are unsubstantiated. We therefore hold that the [district] court did not abuse its discretion . . ." (9th Cir.Opn. [App. A] p. 3729-30.)

[10]*Accord, Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1483 (Fed.Cir. 1983) (upholding denial of access to in-house counsel; "three-part balancing test" used); *F.T.C. v. Exxon Corp.*, 636 F.2d 1336, 1349 (D.C. Cir. 1980) (emphasizing "facts of this case"; denying in-house counsel access); *A. Hirsch, Inc. v. U.S.*, 657 F.Supp. 1297, 1303 (C.I.T. 1987) (weighing "factual circumstances surrounding" in-house counsel; applies balancing test and denies access because risk of disclosure not *de minimis*).

"before crafting the protective order in this case." (9th Cir.Opn. [App. A] p. 3727.)

A moment's perusal of the Order at issue confirms that the Ninth Circuit was entirely correct — the Magistrate did not decide the issue "solely" on the basis that Mr. Flynn was in-house counsel. The Order summarizes the Magistrate's particular factual findings underlying the decision (findings which go far beyond the mere fact of Mr. Flynn's in-house status), and expressly recites that "*[u]nder the circumstances of this case* in-house counsel is so close to the party that the danger of inadvertent disclosure of information is impossible to control." (Mag.Ord. [App. C] p. 2, emphasis added.)

The transcript of the Hearing on this issue (Resp. App. 27) makes it even clearer that the decision on in-house counsel's claim to confidential documents was based upon a thorough examination of the specific functions and duties of in-house counsel.

D. The Factual Record Unambiguously Supports the Magistrate's Exercise of Discretion.

1. There Was a Strong Risk of Inadvertent Disclosure or Misuse of Confidential Information.

The Magistrate specifically found, based on Mr. Flynn's own statements (Resp. App. 20-21, 29-30), that Mr. Flynn's "responsibilities [as Brown Bag's in-house counsel and personnel director] run the gamut of legal issues from personnel to intellectual property" and that his "role is to advise management on all legal issues." (Mag.Ord. [App. C] p. 2.) The company was extremely small, and Mr. Flynn's role, vague but potentially all-encompassing. The Magistrate reached the obviously reasonable conclusion that the practices of so small a company would be informal and fluid, and that it would be impossible to insulate Mr. Flynn from decisions in which defendants' confidential information could provide an important competitive advantage to Brown Bag.

Courts have frequently denied in-house counsel access to the confidential documents of a competitor. *F.T.C. v. Exxon Corp.*, 636 F.2d 1336, 1350 (D.C. Cir. 1980); *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1483 (Fed.Cir. 1983); *A. Hirsh, Inc. v. U.S.*, 657 F.Supp. 1297, 1304 (C.I.T.

1987). In-house counsel like Mr. Flynn advise on corporate planning and strategy, and, having learned their competitor's marketing strategies, new product development plans and trade secrets, cannot provide advice without making conscious or unconscious use of that information. As the Ninth Circuit sagely observed, the Magistrate had to consider "not only whether [Symantec's confidential] documents could be locked up in cabinets, but also whether Brown Bag's counsel could lock up trade secrets in his mind, safe from inadvertent disclosure to his employer once he had read the documents." (9th Cir.Opn. [App. A] p. 3728.)

"It is very difficult for the human mind to compartmentalize and selectively suppress information once learned, no matter how well-intentioned the effort may be to do so." *Exxon,* 636 F.2d at 1350. The risk was acute in this case because Mr. Flynn's duties were neither segregated nor isolated. "[I]n a small corporation where insulation of one department from another is insignificant, if it exists at all, there remains a justified concern that disclosure to [in-house counsel] would place him in the unnatural and unremitting strain of having to exercise constant self-censorship in his normal working relations." *A. Hirsh*, 657 F.Supp. at 1304. Mr. Flynn was not in an insulated department of a big company. He *was* the entire legal "department" — and he doubled as the Human Resources Manager.

Based on the entire record, the court found that Mr. Flynn was "so close to the party that the danger of inadvertant disclosure of information is impossible to control." (Mag.Ord. [App. C] p. 4.) That factual finding conclusion is unassailable and has not been challenged as clearly erroneous. The Magistrate's decision to limit Mr. Flynn's access initially to an independent consultant, pending a particularized showing of relevance, was plainly not an abuse of discretion. Rather, it was a measured response, carefully balancing the competing interests.

2. The Confidential Documents Are in Fact Utterly Irrelevant.

There is a simple explanation for Brown Bag's failure to have its independent consultant review the documents. Brown Bag knew they were completely irrelevant. This case involves a claim that the user interface of GrandView is substantially similar to

that of PC-Outline. The user interface is not secret, and a "look and feel" claim can be assessed by examination of the published works, not by studying trade secrets or confidential documents. Similarly, Symantec's marketing plans, the identity of its "beta" testers, and the appearance of earlier unpublished versions of the program are irrelevant to the real issues.

Now, as an afterthought not raised before the Magistrate or the Ninth Circuit, Brown Bag dreams up a new theory — that the confidential documents bear on a hypothetical claim that the computer code underlying Symantec's program was copied from Brown Bag's program. Obviously, it was not an abuse of discretion for the Magistrate to fail to consider such an argument when it was never placed before her.

Brown Bag's failure to make any meaningful offer concerning the relevance of Symantec's confidential documents is particularly telling because Brown Bag's outside attorneys had the confidential documents in their possession for six months. The Magistrate's Order provided — and Brown Bag spurned — yet another practical means of determining whether the documents were relevant. On this record, Brown Bag can show neither that the Magistrate's order was improper nor that the order could have had any impact whatsoever on the outcome.

In conclusion: The Magistrate patiently explored all of the facts and circumstances before issuing her order. The risk of inadvertant disclosure was high. The documents were irrelevant. The Magistrate's carefully crafted decision was not an abuse of discretion.

II.

THE COURT CANNOT ON THIS RECORD REACH PETITIONER'S COPYRIGHT CONTENTIONS.

Petitioner's only substantive argument on appeal and here is its assertion that the trial court committed reversible error by failing to compare *as a whole* the plaintiff's work with Symantec's work. But, as the Ninth Circuit indicated, there can be no reversible error — and the issue cannot be reached — where petitioner itself invited the very analytic dissection which it now condemns; where petitioner never put the entire works before the district court; and

where petitioner never even asked the district court to perform the analysis it now requests. (9th Cir.Opn. [App. A] pp. 3737, 3739.)

A. Brown Bag Waived any Claim That The District Court Erred in Not Comparing The Works as Wholes.

The gravamen of plaintiff's copyright argument is now that the district court failed to compare the plaintiff's work as a whole with Symantec's work as a whole.

It is difficult to even imagine the good-faith basis upon which Brown Bag asserts this argument since Brown Bag never asked the district court to compare the works as a whole and never offered the two programs in opposition to summary judgment so that such a determination could be made. Brown Bag's omissions constitute a waiver. (9th Cir.Opn. [App. A] p. 3739.)

B. Brown Bag's Limited Evidentiary Showing Was Insufficient to Meet its Burden on Summary Judgment.

In order to avoid summary judgment, Brown Bag was required to "come forward with all of [its] evidence," *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and make a showing sufficient to establish the essential elements on which it will bear the burden of proof at trial. *Id.* at 322. Brown Bag presented no such evidence to the district court. Its "evidence" consisted entirely of Mr. Ogg's list of allegedly similar features. Brown Bag did *not* offer copies of the actual programs so that they could be compared as wholes, and Mr. Ogg did not even refer to any exhibits. Lists of purported similarities are insufficient to demonstrate substantial similarity because "such lists . . . are inherently subjective and unreliable." *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984). Thus, Brown Bag's showing was inadequate on its face.

It would be absurd to suggest that, faced with Brown Bag's inadequate response, it was the duty of the district court to create a sufficient record on Brown Bag's behalf. Brown Bag neither asked the district court to engage in a comparison of the works as wholes nor provided the court with evidence from which anyone could conclude that the works in their entireties were substantially similar. The claim that the district court erred in failing to perform an analysis it was never asked to perform and for which Brown Bag provided no basis in the record can hardly constitute a basis for reversal.

Symantec's and Friend's comprehensive comparison of the two programs, offered in support of summary judgment, confirms that Brown Bag's decision not to place the programs into evidence was no oversight. The state of the record does not reflect any inadvertant evidentiary lacuna. Rather, Brown Bag preferred to try to make out its case based on a list of isolated, supposed similarities precisely because it was well aware that a more complete examination of the two programs would confirm that the user interfaces of the two programs are systematically and thoroughly different.

C. The Court "Carefully Reviewed" the Actual Programs and Sought to Consider Brown Bag's Claims in Context.

Notwithstanding Brown Bag's failure to provide the district court with any meaningful basis for considering Brown Bag's contentions, in an effort to place Brown Bag's list in an appropriate perspective the court did, *sua sponte*, direct the parties to demonstrate the programs at issue at the summary judgment hearing and to provide the court with copies of the programs that could be examined in chambers. We emphasize, however, that Brown Bag still did not provide a proper evidentiary basis for its claims and that the court's *sua sponte* action did not cure petitioner's failure to introduce evidence. The defect is not merely a technical one because, among other reasons, the authenticity of the materials used by Brown Bag in the demonstration was itself at issue.[11]

The district court stated that it had "carefully reviewed" the actual programs, using the Ogg list of features as a basis of comparison. (D.Ct.Opn. [App. B] pp. 1, 7) The Court methodically considered each feature alleged to be similar and concluded that all of the features on Brown Bag's list were either (1) different in the two programs, (2) expressly licensed to Friend, and/or (3) unprotectable under copyright. (*Id.* p. 14.)

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[11]There was a controversy at the summary judgment hearing over whether Brown Bag had "doctored" the color arrangements on the program used for its part of the presentation. (Docket Nos. 161 & 163.) Brown Bag never submitted authenticated copies of the actual programs as evidentiary exhibits nor did Brown Bag lay any foundation for admitting those copies into evidence. Hence, the programs at issue are in no way part of the record.

Contrary to Brown Bag's assertions, the court did, within the serious limits of Brown Bag's evidentiary showing, consider the entire programs and found no substantial similarity. The district court begins its opinion by stating that it was "called upon to decide whether the 'look and feel' of the screen displays" are substantially similar (D.Ct.Opn. [App. B] p. 1). Following its review of the functioning of all nine menus (essentially the entire user interface), the Court states its overall conclusion that "[t]he expression of the ideas inherent in the features [in GrandView] are . . . distinct" from PC-Outline (p. 10). And going beyond Brown Bag's limited paper showing of purported opening screen similarity, the Court "review[ed] the expression of that idea on the screen" and found that "no reasonable jury could find" the two actual screens to be substantially similar. (pp. 12-13.)

The district court's fact-finding concerning the differences in the user interfaces of the two programs was undisputed and is unimpeachable. It was and is uncontested that the menu structures and terminology of the two programs are different; that the opening screens are starkly different whether viewed element by element or as an entirety; that almost 90% of the keystroke shortcuts are different; and that three-quarters of the default color selections are different. (Docket No. 130, ¶¶ 26(a),(b),(e).) Even if the district court had some duty to examine the programs as wholes and even if it were shown that the district court failed to do so, reversible error still could not be shown because, on the undisputed facts, a comparison of the works in their entirety can only yield the conclusion that the works as a whole are different and that summary judgment was appropriate.

III.

SUMMARY JUDGMENT WAS REQUIRED BECAUSE THE UNCONTESTED RECORD SHOWS THAT GRANDVIEW AND PC-OUTLINE ARE NOT SUBSTANTIALLY SIMILAR.

On the uncontested record of facts which the defendants systematically and painstakingly assembled and put before the district court, any comparison of the works compels the conclusion that GrandView and PC-Outline are not substantially similar. If, as Brown Bag now argues, PC-Outline were treated as a

compilation, summary judgment is still plainly required because it is uncontested that the arrangement of elements is different in the two programs.

To establish copyright infringement, a plaintiff must prove that he owns a valid copyright and that the defendant copied the copyrighted work. *Sid & Marty Krofft Television Prod., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977). A *prima facie* case of "copying" is usually proven by circumstantial evidence — "access" by the defendant to the plaintiff's work and "substantial similarity" between the defendant's work and the plaintiff's work — but the *prima facie* case can be rebutted by evidence of independent creation of the accused work. *See, e.g., John L. Perry Studio, Inc. v. Wernick*, 597 F.2d 1308, 1309-10 (9th Cir. 1979). In this case "access" is not at issue.

A. The Scope of Brown Bag's Copyright Was Limited By Its Concessions Regarding Copyrightability.

It is axiomatic that copyright law protects only expression, not the ideas underlying that expression. 17 U.S.C. § 102(b); *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, ____ U.S. ____, 113 L.Ed.2d 358, 368 (1991); *Data East USA v. Epyx, Inc.*, 862 F.2d 204, 207 (9th Cir. 1988).

Copyright protection does not extend to an idea or even "to elements of expression that necessarily follow from the idea." *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987). This notion of "merger" between idea and expression affects the substantial similarity comparison:

> "To the extent that it is necessary to determine whether similarities result from unprotected expression, it is appropriate . . . to perform analytic dissection of the similarities."

Id. As the Ninth Circuit pointed out in this case, such analytic dissection is used, "not for the purpose of comparing similarities and identifying infringement, but for the purpose of defining the scope of plaintiff's copyright." (9th Cir.Opn. [App. A] p. 3738.) *Accord, Feist*, 113 L.Ed.2d at 371 ("The mere fact that a work is copyrighted does not mean that every element of the work may be protected."); *Concrete Machinery Co. v. Classic Lawn Ornaments*, 843 F.2d 600 (1st Cir. 1988); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2nd Cir. 1980).

Indeed, in another case involving allegedly similar computer screen displays, the Ninth circuit held that "it was clear error for the District Court to determine that protectable substantial similarity existed" based upon "similarities result[ing] from unprotectable expression." *Data East*, 862 F.2d at 209. "The lower court erred by not limiting the scope of Data East's copyright protection to the author's contribution . . . ." *Id.*; *accord, Frybarger v. IBM Corp.*, 812 F.2d 525, 529-30 (9th Cir. 1987).[12]

Under the controlling copyright authority in the Ninth and other Circuits, then, the trial court was required in making its "substantial similarity" analysis to determine whether each allegedly similar feature constituted copyrightable subject matter and to compare only features in the two programs constituting copyrightable subject matter.

> "What is important is not whether there is substantial similarity in the total concept and feel of the works, but whether the very small amount of protectible expression in [the accused work] is substantially similar to the equivalent portions of [the plaintiff's work]."

Cooling Systems & Flexibles v. Stuart Radiator, 777 F.2d 485, 493 (9th Cir. 1985).

Turning to our case, Brown Bag never disputed in the district court that the only elements of GrandView that were similar to PC-Outline were unprotected or unprotectable subject matter. Likewise on appeal, Brown Bag did not take issue with the lower court's conclusion that the only similarities between the two programs were uncopyrightable functions or licensed features. In the Ninth Circuit, as here, Brown Bag's sole substantive argument was that PC-Outline as a whole could be nonetheless protectable as a compilation.

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[12]In a number of cases involving artistic works such as greeting cards, courts have not required excission of noncopyrightable elements. *See, e.g., Roulo v. Russ Berrie & Co.*, 886 F.2d 931 (7th Cir. 1989), and *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970). The computer outlining programs at issue here are not artistic works, however, and the standard of *Roulo* and *Roth* are inapposite by their own terms.

For the reasons stated in the previous Argument, Brown Bag is barred from contending that the district court erred by failing to compare the works as a whole. Even were that not so, however, Brown Bag's compilation claim cannot withstand scrutiny because Brown Bag cannot show "bodily appropriation" of the arrangement of elements of its interface.

B. Brown Bag Cannot Meet the Standard For Infringement of Compilations.

Doubtless, the selection, coordination and arrangement of noncopyrightable elements may in some cases qualify for copyright protection as a "compilation." 17 U.S.C. § 103(a); *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197 (9th Cir. 1989). But the copyright in a compilation is "thin," and "the copyright is limited to the particular selection or arrangement." *Feist*, 113 L.Ed.2d at 371, 372. "Even if a work qualifies as a copyrightable compilation, it receives only limited protection." *Feist* at 377.

That protection does not "imply any exclusive right in the preexisting material," as opposed to the arrangement itself. 17 U.S.C. § 103(b). Moreover, "copyright infringement of compilations consisting largely of uncopyrightable elements should not be found in the absence of '*bodily appropriation* of expression.'" *Harper House* at 205 (emphasis added).

Here, the selection and arrangement of noncopyrightable elements were dictated largely by the requirements of outlining itself. (Docket No. 122, Exh. A, pp. 30-31, 39-43.) More importantly, it is uncontested that GrandView's selection and arrangement of those elements is *different* from PC-Outline's: The selection, arrangement and titles of GrandView's menus were demonstrated (and admitted) to be different from PC-Outline's, as were the programs' opening screens, 90% of the keystroke shortcuts and three-quarters of the default color selections. (Docket No. 130, ¶¶ 26(a),(b),(e).) If PC-Outline constituted a copyrightable "compilation" of noncopyrightable elements, Brown Bag would have no interest in the pre-existing elements of the compilation as opposed to the arrangement itself. 17 U.S.C. § 103(a); *Feist*. Since the arrangement is admittedly very different in Symantec's Grandview, and there has therefore been no "bodily appropriation" of Brown Bag's arrangement, Brown Bag

has no claim for relief. *Harper House* at 205 (bodily appropriation requires substantially identical copying of the entire item). Hence, even if the district court had somehow erred by failing to compare the two works "as wholes" and if PC-Outline were protectable as a compilation, on the undisputed facts Brown Bag's arrangement of elements was not infringed by GrandView.

CONCLUSION

Brown Bag's contentions on appeal and here are mere afterthoughts with no merit. Brown Bag's discovery claim is frivolous, and, on the uncontested facts, its copyright arguments are insubstantial. Brown Bag presents no issue worthy of this Court's attention. Symantec respectfully requests that certiorari be denied.

DATED: August 21, 1992

FENWICK & WEST

By: Mitchell Zimmerman

Mitchell Zimmerman
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Symantec Corporation

Supreme Court, U.S.
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No. 92-178

In The

SUPREME COURT OF THE UNITED STATES

October Term, 1992

BB ASSET MANAGEMENT, INC. dba BROWN BAG SOFTWARE,

PETITIONER

vs.

SYMANTEC CORPORATION AND JOHN L. FRIEND, AN INDIVIDUAL AND dba SOFTWORKS DEVELOPMENT,

RESPONDENTS

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITIONER'S REPLY BRIEF IN RESPONSE TO RESPONDENTS' BRIEF IN OPPOSITION

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INTRODUCTION

Petitioner's Reply Brief discusses Respondent Symantec's Opposition Brief in terms of the questions presented by Brown Bag in its Petition. Symantec's Opposition Brief contains matters which appear irrelevant to this appeal and inappropriate in any event. These matters are not discussed in this Reply Brief. However, Brown Bag reserves the right to address them at a later time should it be considered appropriate.

QUESTION I.

IS A PARTY TO LITIGATION DEPRIVED OF ITS CONSTITUTIONAL RIGHT TO COUNSEL OF ITS CHOICE UNDER THE FIFTH AND SIXTH AMENDMENTS WHEN THE COURT DENIES THAT PARTY ACCESS TO THE CONFIDENTIAL DOCUMENTS UNDER A PROTECTIVE ORDER IN THE CASE SOLELY BECAUSE THAT PARTY'S TRIAL COUNSEL IS THAT PARTY'S IN-HOUSE GENERAL COUNSEL?

Petitioner's premise is that the issue of access to confidential information under a protective order should be determined strictly on the basis of counsel's qualifications and need for access rather than resting on arbitrary distinctions between employed and retained counsel.

WAS BROWN BAG'S TRIAL COUNSEL DENIED ACCESS SOLELY BECAUSE HE WAS BROWN BAG'S IN-HOUSE GENERAL COUNSEL?

On P. 18 of its Opposition Brief, Symantec challenges Question I as presented by Brown Bag. Brown Bag phrased its Question I in terms of Brown Bag's trial attorney having

been denied access to the confidential documents under a Protective Order solely because he was Brown Bag's in-house general counsel.

On P. 14 of its Petition, Brown Bag quoted from U.S. Steel Corp. v. United States, 730 F.2d 1465 (Fed. Cir. 1984) at P. 1469:

> The certified question (whether access may be granted to retained and denied to in-house counsel solely on a presumption that inadvertent disclosure by the latter is more likely) is answered in the negative, i.e., a denial of access sought by in-house counsel on the sole ground of their status as in-house counsel is error.

Thus, the U.S. Steel court has equated denial of access solely on a presumption that inadvertent disclosure by in-house counsel is more likely with denial of access solely on the ground of status as in-house counsel. The U.S. Steel court stated on P. 1468 that denial or grant of access cannot rest on a general assumption that one group of lawyers are more likely or less likely inadvertently to breach their oath under a protective order.

In the instant case, the Magistrate's Order (Petitioner's Appendix, P. c4) stated:

> Under the circumstances of this case in-house counsel is so close to the party that the dangers of inadvertent disclosure of information is impossible to control.

Apparently, the Magistrate's phrase, "Under the circumstances of this case," refers to the prior paragraph which generally states that in-house counsel's responsibilities run the gamut of legal issues and that in-house counsel's role is to advise management on all legal issues. Since these are merely the general functions of an in-house attorney, the Magistrate denied access solely on the basis that Brown Bag's attorney was more likely inadvertently to breach his duty under the existing Protective Order solely because he was in-house general counsel.

In U.S. Steel Corp. v. United States, 730 F.2d 1465, the court stated at P. 1467:

> The denial of access here rested on the court's stated general assumption that there is a "greater likelihood of inadvertent disclosure by lawyers who are employees committed to remain in the environment of a single company". Denial or grant of access, however, cannot rest on a general assumption that one group of lawyers are more likely or less likely inadvertently to breach their duty under a protective order. Indeed, it is common knowledge that some retained counsel enjoy long and intimate relationships and activities with one or more clients, activities on occasion including retained counsel's service on a corporate board of directors. Exchange of employees between a client and a retained law firm is not uncommon. Thus the factual circumstances surrounding each individual counsel's activities, association, and relationship with a party, whether counsel be in-house or retained, must govern my concern for inadvertent or accidental disclosure.

Brown Bag stated on P. 13 of its Petition that both Brown Bag's President and in-house general counsel had submitted declarations which stated that Brown Bag's in-house general counsel was not involved in product positioning. Brown Bag's President also stated in his declaration that he would ensure that no one at Brown Bag interfered in any way with the obligations imposed by the Protective Order on in-house counsel.

WHAT IS THE EFFECT OF THE MAGISTRATE'S AUTHORIZING BROWN BAG TO SEEK THE SERVICES OF AN INDEPENDENT CONSULTANT TO REVIEW AND ADVISE ON ISSUES INVOLVING THE CONFIDENTIAL DOCUMENTS?

On P. 18 of its Opposition Brief, Symantec points out that the Magistrate authorized Brown Bag to seek the services of an independent consultant to review and advise on issues involving the confidential documents. Brown Bag discussed this issue in its Petition on P. 15. Retention of a consultant was not a viable alternative. Trial counsel cannot effectively represent his client if shown only certain documents selected by a consultant after a costly and time-consuming proceeding. To make informed decisions regarding case management, counsel must evaluate personally all aspects of a case. Since Respondents' trial counsel had access to all of Brown Bag's confidential documents under the Protective Order, Brown Bag was at a great disadvantage without similar access.

SYMANTEC'S CASE AUTHORITY

Symantec relies on three cases. In its Opposition Brief at P. 21, Symantec states:

> Courts have frequently denied in-house counsel access to the confidential documents of a competitor. F.T.C. v. Exxon Corp., 636 F.2d 1336, 1350 (D.C. Cir. 1980); Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1483 (Fed. Cir. 1986); A. Hirsh, Inc. v. U.S., 657 F.Supp. 1297, 1304 (C.I.T. 1987).

Regarding the latter case, Symantec states in its Opposition Brief at P. 22:

> "[I]n a small corporation where insulation of one department from another is insignificant, if it exists at all, there remains a justified concern that disclosure to [in-house counsel] would place him in the unnatural and unremitting strain of having to exercise constant self-censorship in his normal working relations. A. Hirsh, 657 F.Supp. 1297, at 1304.

In order to place the foregoing in proper perspective, let's examine the circumstances. In A. Hirsh, 657 F.Supp. 1297, the court stated at P. 1299:

> David B. Hirsh, Esq. is general counsel and chief legal officer of the plaintiff A. Hirsh, Inc., a corporation that imports the paint brushes subject to the anti-dumping-duty order and that is owned and operated by Mr. Hirsh's father, Erwin Hirsh, who manages the firm along with David's brother. See Hirsh Affidavit, para. 5. From February 20, 1981 until July 28, 1986, David. Hirsh was empowered by plaintiff's board of

directors "to perform the duties and exercise the powers of the presidency in the absence or disability" of his father. (Footnote omitted.)

At P. 1303 and P. 1304, the Hirsh court stated:

Although perhaps not directly "involved in the competitive decision-making of the company", Mr. Hirsh until recently was empowered with the authority to act as its president under certain limited circumstances, See Hirsh Affidavit, para. 6. He continues to serve as an officer of the plaintiff. See Plaintiff's Motion, p. 2; Hirsh Affidavit, para. 4. These facts, in addition to his familial ties to plaintiff's operating officers, suggest a lack of isolation of Mr. Hirsh from the commercial activities of the company, thus creating an "unacceptable opportunity for inadvertent disclosure." (Footnotes omitted.)

At P. 1305, the Hirsh court said:

While access is necessary in order to prepare plaintiff's case, its need has already been satisfied by disclosure to its retained counsel, James A. Resti, Esq., under the December 1st protective order.

Further on P. 1305, the Hirsh court stated:

In short, in view of retained counsel's competence, it is not clear how plaintiff's position will be prejudiced by excluding Mr. Hirsh from access to the nonpublic part of the agency record.

Thus, the Hirsh case is easily distinguished. Brown Bag's Petition, P. 9 and P. 10, refers to the declarations submitted by Brown Bag's in-house counsel and by Brown Bag's Presi-

dent. These declarations stated that in-house counsel was neither an officer nor a director of Brown Bag, played no management role in the product positioning of Brown Bag and, so far as was known, was not related to any other person at Brown Bag. Brown Bag's President further declared that he would ensure that no one at Brown Bag interfered in any way with the obligations imposed by the Protective Order on in-house counsel.

The Hirsh court gave great weight to the presence of outside counsel in the case. The Hirsh court stated at P. 1305 that it was not clear how plaintiff's position would be prejudiced by excluding Mr. Hirsh in view of retained counsel's competence. IN THE INSTANT CASE, BROWN BAG WAS GREATLY PREJUDICED SINCE THERE WAS NO OUTSIDE COUNSEL. In-house counsel was the counsel of choice of Brown Bag.

In Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471 (Fed. Cir. 1986), the court said at P. 1483:

> However, "[i]n section 337 investigations, it is the exception rather than the rule to release confidential information to in-house counsel."
>
> The primary justification for the Commission's reluctance to grant adversary management and in-house counsel access to confidential business information is that, in order to discharge its statutory responsibilities within the strict statutory time limits, the Commission is heavily dependent on the voluntary submission of information. Disclosure of sensitive materials to an adversary would undoubtedly have a chilling effect

on the parties' willingness to provide the confidential information essential to the Commission's fact-finding process.

Both A. Hirsh, 657 F.Supp. 1297 and Akzo N.V., 808 F.2d 1471, are trade cases covered by special provisions enacted by Congress. Those provisions are discussed in Akzo N.V. 808 F.2d1471, at P. 1483, where the court acknowledged that a conservative position on the side of optimum shielding of business information is used in trade cases.

The third case relied on by Symantec is F.T.C. v. Exxon Corp., 636 F.2d 1336 (D.C. Cir. 1980). This also is a special circumstances case involving a Federal agency, the Federal Trade Commission. The following appears at P. 1336:

> Order prohibiting in-house and retained counsel for corporation from having attorney-client relationship with wholly-owned subsidiary during course of Federal Trade Commission administrative proceeding that might result in divestiture of subsidiary from corporation was proper exercise of inherent equitable power of district court where corporation had been ordered to hold separate subsidiary pending outcome of the administrative proceedings, in that even though corporation and its subsidiary shared common interest in obtaining approval of the acquisition of subsidiary, possibility existed that divestiture would be ordered, which possibility gave rise to a fundamental conflict between corporation and subsidiary, and thus it was essential that hold separate order be rigorously enforced, and prohibition order was necessary to fully effectuate the order.

Further, in F.T.C. v. Exxon Corp., 636 F.2d 1336, the court stated at P. 1350:

> This concern over the very close relationship between in-house and other personnel of the corporation is well-illustrated in this case. Exxon requested access for only two members of the Exxon legal department: Richard Keresey and Donald Farley. As noted by the FTC, at the time Exxon made this request, Mr. Keresey sat on the board of directors of Exxon Enterprises, Inc., which then held Exxon's ACS operations. The relationship of Mr. Farley to Exxon's drives operation has been disputed by the parties. In any event, the District Court was faced with a possibility that both men had been closely involved with matters concerning Exxon's entrance as a competitor in the drives market, and could continue to be so involved in the future. (Footnotes omitted.)

Again, in the instant case both Brown Bag's in-house counsel and Brown Bag's President submitted declarations stating that Brown Bag's in-house general counsel was neither an officer nor a director of Brown Bag. Petition, P. 10.

In F.T.C. v. Exxon Corp., the court stated at P. 1342:

> First, we emphasize that in the FTC proceeding challenging the acquisition of Reliance, Exxon's interests will be represented by counsel of Exxon's choice. Exxon had retained counsel for that proceeding. Moreover, as a result of the modification requested by Exxon and incorporated in the June 25 Order, that counsel has access to all information of the Drives Group that is necessary to defend the acquisition. Exxon admits in its brief that "[t]he only additional information that would come to counsel as a result of

there being an ordinary attorney-client relationship would be irrelevant or privileged information." Brief of Appellant, p.25. Exxon has not claimed that it is in any way prejudiced by its inability to secure such information. (Footnote omitted.)

Thus, as in all of the other cases cited by Symantec, there are both in-house and retained counsel. BROWN BAG IS A CASE OF FIRST IMPRESSION ON THE CONSTITUTIONAL RIGHT TO COUNSEL. Brown Bag's litigation counsel is its only counsel and is its in-house general counsel.

Symantec submitted a separate document titled "Respondent's Appendix" with its Opposition Brief. Respondent's Appendix contained the transcript of proceedings before the Magistrate concerning Symantec's motion to have Brown Bag's in-house general counsel/litigation counsel excluded from access to the confidential documents under the existing Protective Order which authorized access by counsel of record and did not differentiate between retained and employed counsel. The transcript quotes Brown Bag's in-house general counsel at P. 45:

All right. Finally, I'd just like to say, Your Honor, that I've heard some implications here almost to the effect that in house counsel are second class citizens, that eventually outside counsel have to be brought into a case and I'm not aware of any authority in that way. It's perfectly acceptable for in house counsel to involve themselves in litigation. In fact, its done in many companies. I don't want to be thought of as a temporary stop gap person who is only here for, until outside counsel can be brought in or until we're told to bring outside counsel in. It's a very small company,

very few employees, very low sales and this is the way that the case is going forward at this point with inside counsel and I don't want to speculate as to whether or not outside counsel might be brought in, in the future.

QUESTION I SUMMARY

Brown Bag is a case of first impression on the right to counsel issue. In all the cases cited by Petitioner and Respondent, there were both retained and employed counsel. In the instant case, Brown Bag's in-house general counsel is its litigation counsel. Thus, denying Brown Bag's counsel access to the confidential documents under the terms of the Protective Order is effectively denying Brown Bag the right to counsel of its choice. Brown Bag's counsel was denied access to the computer source code and to other information critical to the development of Brown Bag's case. For example, without GrandView's source code, Brown Bag's counsel could not compare it with that of PC-Outline. If the two codes appeared substantially similar Brown Bag could have proceeded under a direct source code copying theory under its Complaint.

Counsel for Symantec and Mr. Friend had access to all of Brown Bag's confidential documents. Brown Bag proceeded with the equivalent of one hand tied behind its back, and Respondents prevailed on summary judgment. Having a consultant decide which documents Brown Bag should request from the court would have been costly, time consuming and would not have placed the parties on an equal footing. Brown Bag's counsel might have eventually obtained access

to some of the less important documents, but Respondents had automatic access to all of Brown Bag's confidential documents early on without the costly and time consuming process outlined by the Magistrate. Without access to all of the confidential documents, Brown Bag's counsel could not properly evaluate, plan and manage the case. Litigation counsel is the case manager, not some consultant. Petitioner respectfully suggests that this Honorable Court rule that the issue of access be determined strictly on the basis of counsel's qualifications and need for access rather than relying on arbitrary distinctions between employed and retained counsel.

In the event that this Honorable Court should decide to place the parties on an equal footing by allowing Brown Bag's trial counsel access to the confidential documents under the Protective Order, Brown Bag respectfully requests that discovery be re-opened for a period of at least 90 days to permit Brown Bag to evaluate and use the information.

QUESTION II.

IN PERFORMING A COMPARISON OF TWO COMPUTER SOFTWARE PROGRAMS UNDER THE COPYRIGHT LAW TO DETERMINE IF THE TWO PROGRAMS ARE SUBSTANTIALLY SIMILAR:

A. SHOULD THE COURT COMPARE THE OVERALL "LOOK AND FEEL" OF THE TWO PROGRAMS OR MAY THE COURT MERELY COMPARE CERTAIN ELEMENTS OF THE TWO PROGRAMS?

B. SHOULD THE COURT RESOLVE THE IDEA/EXPRESSION DICHOTOMY BY APPLYING THE ABSTRACTIONS SCALE OF JUDGE LEARNED HAND?

C. SHOULD THE USE OF LAY AND EXPERT OPINION BE ALLOWABLE IN A SINGLE SUBSTANTIAL SIMILARITY INQUIRY?

Question II is a three-part question. Each part will be addressed in order.

A. SHOULD THE COURT COMPARE THE OVERALL "LOOK AND FEEL" OF THE TWO PROGRAMS OR MAY THE COURT MERELY COMPARE CERTAIN ELEMENTS OF THE TWO PROGRAMS?

Mr. Friend sold PC-Outline to Brown Bag by means of a written Purchase and Sale Agreement dated April 17, 1987. Petition, P. 4 and Opposition Brief, P. 8. Symantec states at P. 9 of its Opposition Brief:

> Also in 1987, Friend developed the outlining program which came to be known as "GrandView," and sold the marketing rights to that program to Symantec. (Docket Nos. 130, 121.) Immediately after their agreement was signed, Symantec and Friend began a protracted process of consultations over modifying the user interface of GrandView, specifically to ensure that GrandView's user interface would be more similar to that of Symantec's existing programs MORE and ThinkTank. (Footnote omitted.)

Mr. Friend stated that the program which he sold to Symantec, and which eventually was named GrandView, had

been titled PC-Outline 2. Petition P. 5 and Mr. Friend's Deposition of October 18, 1988, P. 110, Lines 7-8.

Thus, Symantec and Mr. Friend worked together to modify PC-Outline 2 to "...ensure that GrandView's user interface would be similar to that of Symantec's existing programs...". Did Symantec and Mr. Friend change enough items to get around Brown Bag's copyright or was the overall "look and feel" of the programs substantially similar?

The foregoing shows why it is important to compare the overall "look and feel" of the programs in addition to comparing individual elements after performing analytic dissection. Individual elements may be changed, but the overall "look and feel" may remain the same.

Symantec states "Brown Bag did not offer copies of the original programs so that they could be compared as wholes...". Opposition Brief, P. 24. Symantec further states on P. 24 of its Opposition Brief:

> Brown Bag neither asked the district court to engage in a comparison of the works as wholes nor provided the court with evidence from which anyone could conclude that the works in their entireties were substantially similar.

However, Symantec then goes on state on P. 25 that the court directed the parties "...to demonstrate the programs at issue at the summary judgment hearing and to provide the court with copies of the programs that could be examined in chambers." Thus, the district court had the programs before

it. Brown Bag, 12 USPQ2d 1991, 1992 (Petitioner's Appendix B) and Appeals Court Decision, P. 3739 (Petitioner's Appendix A). At 12 USPQ2d 1991, 1992, the district court stated:

> The Court is called upon to decide whether the "look and feel" of the screen displays in defendants' computer outlining program are substantially dissimilar from plaintiff's copyrighted program so as to justify a grant of summary judgment.

Thus, the district court had the programs before it and stated that it was called upon to decide whether the "look and feel" of the programs was dissimilar. Therefore, the issue of substantial similarity was before the court for its proper determination.

On P. 28 of its Opposition Brief, Symantec cites Cooling Systems & Flexibles v. Stuart Radiator, 777 F.2d 485, 493 (9th Cir. 1985) for the proposition that what is important is not whether there is substantial similarity in the total concept and feel of the works, but whether the very small amount of protectible expression in the accused work is substantially similar to the equivalent portions of the plaintiff's work.

However, Cooling Systems was a case involving catalogs. The Cooling Systems court stated on P. 491:

> Catalogs, by definition, are saturated with facts, numbers, and literal depictions of concrete objects. As we emphasized in an only slightly different context, copyright law considers factual works to be fundamentally different from more artistic works: "similar-

> ity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed." (Citation omitted.)

Symantec also states at P. 25 of its Opposition Brief that the court concluded that the features "were either (1) different in the two programs, (2) expressly licensed to Friend, and/or (3) unprotectable under copyright."

Regarding the material which was licensed to Mr. Friend, the Purchase and Sale Agreement states at P. 6 and P. 7 that Mr. Friend was to receive no license to reproduce, adapt or distribute PC-Outline, or any right to utilize the "look and feel" of PC-Outline. Petition, P. 19 and Plaintiff's Opening Brief, Appeals Court, P. 3. Yet, the district court excluded this licensed material from its "look and feel" analysis. In Brown Bag, 12 USPQ2d 1991 (Petitioner's Appendix B), the district court stated at P. 1996:

> The Court finds that it is unnecessary to review the alleged similarities in the drawing of the menu bar, the use of highlighting bars and the use of a single line box around the menus because these features are covered in the license agreement between plaintiff and John L. Friend.

All of the licensed material should have been included in a "look and feel" analysis because of the controlling clause in the Purchase and Sale Agreement described above. Brown Bag's Supplemental Memorandum in Response to Additional Citations Requested by Order of Judges Sneed, Tang and Thompson at Hearing of February 14, 1991, P. 5 and oral

argument before Appeals Court. The district court's analytic dissection and entire "look and feel" analysis is not complete since the court did not include the licensed material.

Thus, the licensed material should be included in the analytic dissection.

On P. 24 of its Opposition Brief, Symantec claims that Brown Bag lacked evidence. Yet Symantec had objected to Brown Bag's evidence which either was not admitted or not discussed by the district court.

Mr. Ogg's declaration was not admitted. Brown Bag, Appeals Court Decision, P. 3733 (Petitioner's Appendix A). Mr. Ogg had not been designated as an expert witness for trial, but he did list his computer background and experience in his declaration. Would his declaration have been admissible if he were chosen at random off the street and had no computer knowledge or experience?

On P. 24 of its Opposition Brief, Symantec cites Litchfield v. Spielberg, 736 F.2d 1352 (9th Cir. 1984) for the proposition that lists of purported similarities are insufficient to demonstrate substantial similarity. The Litchfield court stated at P. 1357: "To constitute infringement of expression, the total concept and feel of the works must be substantially similar. Sid & Marty Krofft, 562 F.2d at 1164."

Mr. Schupper's declaration may not have been considered upon objection. Brown Bag, Appeals Court Decision, P. 3734 (Petitioner's Appendix A). Mr. Schupper's declaration contained various attachments. Attachment 7 was a review of

GrandView published in a legal newspaper. The article stated: "GrandView has the same "look and feel" as PC-Outline." Petition, P. 32 and P. 33.

B. SHOULD THE COURT RESOLVE THE IDEA/EXPRESSION DICHOTOMY BY APPLYING THE ABSTRACTIONS SCALE OF JUDGE LEARNED HAND?

Respondent Symantec did not address this issue in its Opposition Brief.

C. SHOULD THE USE OF LAY AND EXPERT OPINION BE ALLOWABLE IN A SINGLE SUBSTANTIAL SIMILARITY INQUIRY?

Respondent Symantec did not address this issue in its Opposition Brief.

CONCLUSION

The Petition for a Writ of Certiorari should be granted.

Dated: September 14, 1992

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